OPINIONS AND JUDGMENTS OF LOWER COURTS.

Decision of District Judge Schoonmaker dated January 24, 1945, on Motion; reported at 4 F.R.D. 233.

SCHOONMAKER, District Judge.

The complaint in this case is filed under the patent laws of the United States, Section 4915 of the Revised Statutes, U.S.C.A., Title 35, § 63, and under Title 28, § 41(7), of the United States Code Annotated, as a suit arising under the patent laws, and also under the Declaratory Judgments Act, Title 28, § 400.

The complaint alleges two causes of action: (1) A proceeding under Section 4915 of the Revised Statutes with respect to two patent applications for wringers involved in two interferences in the Patent Office,—one by the plaintiff, and the other by defendant, Lovell Manufacturing Company, Assignee of Gustave H. Jantz,—as to which the Commissioner of Patents declared interferences Nos. 75,433 and 76,987, awarding priority of invention to defendant Lovell Manufacturing Company; and (2) an action charging conspiracy between defendants, Lovell Manufacturing Company and Walter H. Kauffmann, II, to produce false and untrue testimony in the proceedings on said interferences and to suppress the true facts with reference thereto; thereby inducing the Patent Office to deprive plaintiff of patents to which he was justly entitled, to the great damage of the plaintiff.

Defendants moved to dismiss that part of the complaint arising out of interference 75,433, based on the allegations of paragraph 17 of the complaint. By leave of court, plain-

tiff amended his complaint by striking therefrom the entire paragraph 17, whereupon was denied the defendants' motion to dismiss the complaint as to interference No. 75,433.

Defendants also filed motions to dismiss, or strike, portions of the complaint for lack of jurisdiction, and also for failure to state claims upon which relief can be granted, and for a bill of particulars.

Paragraph (A) of Defendants' Motion

The question on the motion to dismiss involves a determination of whether or not there may be joined with the action under Sec. 4915, R.S.,—which involves only Interference No. 75,433 and No. 76,987, and rights of the plaintiff and defendant Lovell Manufacturing Company with respect thereto,—an action for a conspiracy and a declaratory judgment which involves the plaintiff and both defendants in this case. Defendants concede that the 4915 actions are filed as a matter of right under the statute to review decisions of the Board of Appeals of the United States Patent Office; but contend that plaintiff may not bring into the 4915 actions a conspiracy count which involves not only the plaintiff and defendant, Lovell Manufacturing Company, but also Walter H. Kauffmann II; and that unless and until plaintiff prevails in his action under Section 4915, R.S., he has no cause of action for conspiracy.

[1] With this contention we cannot agree. It is our view that it is entirely proper to join these two causes of action. This procedure is justified by Rule 18 of the Rules of Civil Procedure, 28 U.S.C.A. following section 723c. Paragraph (a) of that rule provides: "The plaintiff in his complaint * * * may join * * * as many claims either legal or equitable or both as he may have against an opposing party. * * *" And Paragraph (b) provides: "Whenever a claim is one heretofore cognizable only after another claim has been prosecuted to a conclusion, the two claims

may be joined in a single action; but the court shall grant relief in that action only in accordance with the relative substantive rights of the parties. * * *"

[2] We are also of the opinion that the inclusion of Walter H. Kauffmann II as a party defendant is permissible under Rule 20 of the Rules of Civil Procedure. It provides in Subsection (a): "* * * All persons may be joined * * * as defendants if there is asserted against them jointly, severally, or in the alternative, any right to relief in respect of or arising out of the same transactions, occurrence, or series of transactions or occurrences and if any question of law or fact common to all of them will arise in the action. A plaintiff or defendant need not be interested in obtaining or defending against all the relief demanded. Judgment may be given for one or more of the plaintiffs according to their respective rights to relief, and against one or more defendants according to their respective liabilities."

We therefore conclude that paragraph (a) of defendants' motion to dismiss should be denied.

Paragraph (B) of Defendants' Motion

[3] This paragraph alleges that the complaint is insufficient in paragraphs (14) (15), and (16), in that they do not comply with subsections (b) and (g) of Rule 9 of the Rules of Civil Procedure, because the facts are not alleged with sufficient particularity to comply with this rule. Ultimate facts are all that need be stated in a complaint, and in our opinion the complaint is sufficient. If additional particulars of the charge are required, they may be obtained either by bill of particulars or by depositions and discovering proceedings under the Rules of Civil Procedure. As to the allegation in paragraph (15) of the complaint, we do not find that plaintiff is demanding any

items of special damages which would require a specific statement thereof.

The motion to dismiss or strike as to this paragraph will be denied.

Paragraph (C) of Defendants' Motion

This paragraph of defendants' motion states that plaintiff is suggesting in paragraph (14) of the complaint, the issuing of a restraining order against the Commissioner of Patents from issuing a patent to defendant Lovell Manufacturing Company. We do not find any prayer for such restraining order either in paragraph (14) or in the prayers for relief in complaint.

Defendants' motion as to this paragraph will be denied.

Paragraph (D) of Defendants' Motion

This paragraph alleges there is no showing to justify a suggestion in paragraph (14) of the complaint of the danger of the destruction of documentary evidence by defendants, and that therefore an injunction in this respect is not justified. No specific request for such a restraining order has been made by plaintiff.

We therefore decline to strike this paragraph for the reasons alleged.

Paragraph (E) of Defendants' Motion

Plaintiff, of his own motion, amended his complaint by striking out paragraph (17); and there is no reason for passing on defendants' motion with respect to this paragraph.

Paragraph (F) of Defendants' Motion

[4] In this portion of their motion defendants are asking for plaintiff's dates of invention, reduction to practice, etc. As the parties themselves filed in the Patent Office preliminary statements setting forth the dates which

would be relied upon, we see no reason for filing the dates again in this proceeding. This part of defendants' motion will therefore be denied.

Paragraph (G) of Defendants' Motion

This paragraph demands that if paragraphs (14), (15), and (16) are not stricken from the complaint, plaintiff be required to furnish a bill of particulars. Plaintiff has answered this motion, giving such details as he was of opinion should be required of him.

[5] In our opinion the complaint itself gave the defendants the necessary information as to the nature of plaintiff's cause of action, and a bill of particulars was not necessary in this case. The information asked for is largely of an evidentiary character which, in our opinion, can best be obtained under the Rules of Civil Procedure, or by depositions and discovery.

An order may be submitted holding that plaintiff's bill of particulars filed in answer to paragraph (G) of defendants' motion is sufficient, and that no further bill of particulars be required of plaintiff.

Plaintiff may submit orders in accordance with this opinion on notice to defendants' counsel.

items of special damages which would require a specific statement thereof.

The motion to dismiss or strike as to this paragraph will be denied.

Paragraph (C) of Defendants' Motion

This paragraph of defendants' motion states that plaintiff is suggesting in paragraph (14) of the complaint, the issuing of a restraining order against the Commissioner of Patents from issuing a patent to defendant Lovell Manufacturing Company. We do not find any prayer for such restraining order either in paragraph (14) or in the prayers for relief in complaint.

Defendants' motion as to this paragraph will be denied.

Paragraph (D) of Defendants' Motion

This paragraph alleges there is no showing to justify a suggestion in paragraph (14) of the complaint of the danger of the destruction of documentary evidence by defendants, and that therefore an injunction in this respect is not justified. No specific request for such a restraining order has been made by plaintiff.

We therefore decline to strike this paragraph for the reasons alleged.

Paragraph (E) of Defendants' Motion

Plaintiff, of his own motion, amended his complaint by striking out paragraph (17); and there is no reason for passing on defendants' motion with respect to this paragraph.

Paragraph (F) of Defendants' Motion

[4] In this portion of their motion defendants are asking for plaintiff's dates of invention, reduction to practice, etc. As the parties themselves filed in the Patent Office preliminary statements setting forth the dates which

would be relied upon, we see no reason for filing the dates again in this proceeding. This part of defendants' motion will therefore be denied.

Paragraph (G) of Defendants' Motion

This paragraph demands that if paragraphs (14), (15), and (16) are not stricken from the complaint, plaintiff be required to furnish a bill of particulars. Plaintiff has answered this motion, giving such details as he was of opinion should be required of him.

[5] In our opinion the complaint itself gave the defendants the necessary information as to the nature of plaintiff's cause of action, and a bill of particulars was not necessary in this case. The information asked for is largely of an evidentiary character which, in our opinion, can best be obtained under the Rules of Civil Procedure, or by depositions and discovery.

An order may be submitted holding that plaintiff's bill of particulars filed in answer to paragraph (G) of defendants' motion is sufficient, and that no further bill of particulars be required of plaintiff.

Plaintiff may submit orders in accordance with this opinion on notice to defendants' counsel.

Opinion of United States District Court, W. D. Pennsylvania, dated February 28, 1949; reported 83 Fed. Supp. 178.

FOLLMER, DISTRICT JUDGE.

This action was predicated upon a complaint to authorize issuance of patent and for declaratory judgment for injunction and damages and was brought by Nicholas L. Etten, a resident of the State of Iowa, against Lovell Manufacturing Company, a Pennsylvania corporation, and Walter L. Kauffman, II, a resident of the State of Pennsylvania.

The complaint was brought under Section 4915 of the Revised Statutes, 35 U.S.C.A. § 63 and alleged, inter alia, that Nicholas L. Etten, hereinafter called "Etten," on December 23, 1932, filed in the United States Patent Office an application for Letters Patent on his invention of certain improvements in wringers, Serial No. 648,620, on which application Letters Patent No. 2,054,970 was duly granted on September 22, 1936. That Etten filed an application for reissue of the said patent on October 7, 1937, Serial No. 167,775.

That on September 3, 1935, Etten filed in the United States Patent Office an application for Letters Patent on his invention of certain improvements in wringer release mechanism, Serial No. 38,932.

That on October 25, 1934, Gustave H. Jantz, since deceased, alleging to be the inventor of certain improvements in wringers, filed an application for Letters Patent of the United States, Serial No. 749,977, the legal title to which application was assigned to Lovell Manufacturing Company, hereinafter called "Lovell", this assignment being subsequently recorded in the United States Patent Office.

That on February 15, 1938, the Commissioner of Patents declared an interference, No. 75,433, between the Etten

application, Serial No. 38,932, filed September 3, 1935, and the Jantz application, Serial No. 749,977, filed October 25, 1934, the issue of which interference comprised the following count:

> "In a wringer, a frame, rolls mounted in the frame, a removable top bar on the frame, pressure means between the top bar and the rolls, means for detachably securing one end of the bar to the frame, securing means between the other end of the bar and the frame comprising a toggle with one link pivoted to the frame, the other link pivoted to the bar and to said first link, and having an extension forming a handle for manipulating said toggle, the construction being such that the pivots of said links may be brought close to but short of a straight line position, whereby pressure between the bar and the frame will bias said toggle into a released position, and latching connections between said frame and said extension to secure said toggle in a pressure retaining position."

That thereafter, on April 25, 1939, the Commissioner of Patents declared an interference, No. 76,987, between the Etten reissue application, Serial No. 167,775, and the Jantz application, Serial No. 749,977, the issue of which interference comprised the following counts:

> "In a wringer, a frame, rolls mounted in the frame, a removable top bar on the frame, pressure means between the top bar and the rolls, means for detachably securing one end of the bar to the frame, securing means between the other end of the bar and the frame comprising a toggle with one link pivoted to the frame, the other link pivoted to the bar and to said first link, the construction being such that the pivots of said links may be brought close to but short of a straight line position, whereby pressure between the bar and the frame will bias said toggle into a released position, and latching means to secure said toggle in a pressure retaining position."
>
> "In a wringer structure in combination a frame having upright portions, wringer rolls supported by the

upright portions of said frame, a separable cross head member supported by said upright portions, adjustable spring means carried by said cross head member for normally holding said wringer rolls in pressure contact, toggle link mechanism having inseparable members for retaining said cross head member in normal working position and joining the cross head to at least one of the upright portions, a movable latch member for holding the toggle mechanism in operable relation when retained in holding position and so that the pressure load is divided between the toggle mechanism and latch, said spring means being operable to move the toggle mechanism when the latch is not retained in holding position whereby the pressure between the rolls is released."

"In a wringer mechanism, in combination, wringer rolls, an adjustable pressure sustaining means therefor which is retained at one end partly by toggled links and partly by a removable hook, which hook is adapted to be removed from its pressure supporting position by the operation of one or more hand rails disposed adjacent the wringer rolls."

That after hearing on said Interferences No. 75,433 and No. 76,987, the Examiner of Interferences of the Patent Office awarded priority therein to Jantz. That on appeal the decision of the said Examiner was affirmed by the Board of Appeals of the United States Patent Office. That no appeal has been taken by the plaintiff on either of said Interferences, No. 75,433 or No. 76,987, to the United States Court of Customs and Patent Appeals to review the decision of the Board of Appeals. That in the said interferences the defendants, Walter L. Kauffman, II, hereinafter called "Kauffman", Lovell, and their assignor, Jantz, conspired in the concealment of material evidence, put in evidence false and untrue testimony as to material facts, knowing the same to be false and untrue and with the intention that they be relied upon by the United States Commissioner of Patents, the Examiner of Interferences,

and the Board of Appeals of the United States Patent Office; that the said officials did rely upon said false and untrue testimony, resulting in the awarding of priority of invention of the subject matter of said interferences to the said Gustave H. Jantz.

The answer denies that plaintiff has a right to maintain an action under Section 4915 of the Revised Statutes 35 U.S.C.A. § 63, and further asserts that "Defendants can find no complaint for declaratory judgment." Defendant further contends that plaintiff by taking an appeal to the United States Court of Customs and Patent Appeals under Section 4911 of the Revised Statutes, 35 U.S. C.A. § 59a, in Interferences Nos. 77,671 and 77,672, having the same record as Interferences Nos. 75,433 and 76,987, has waived his right to proceed under Section 4915 and that the plaintiff is estopped here because of the adjudication of the Court of Customs and Patent Appeals.

On October 21, 1947, in view of the fact that subsequent to the filing of the original action under Section 4915 the "Jantz" patent had been issued, the plaintiff moved to include an action under Section 4918, 35 U.S.C.A. § 66. Accordingly, the plaintiff was permitted to amend his Bill of Complaint on his motion setting forth that on September 3, 1946, Jantz's application, Serial No. 749,977, filed October 25, 1934, issued to defendant, Lovell Manufacturing Company, as Letters Patent No. 2,406,951; that said patent is in direct conflict with plaintiff's Letters Patent No. 2,054,970, hereinabove referred to.

Defendant then filed a supplemental answer (paragraphs 26 to 29 inclusive) and counterclaim for patent infringement (paragraphs 30 to 34 inclusive).

Paragraph 26 averred that Jantz was the first inventor of the invention defined in his Patent No. 2,406,951 issued

September 3, 1946, on application Serial No. 749,977, filed October 25, 1934.

Paragraph 27 averred the unpatentability of claims 5 and 6 of Etten Patent No. 2,054,970.

Paragraph 29 averred plaintiff could not assert claims 2, 5, and 13 of his Patent No. 2,054,970 under Revised Statutes 4918, or, in the alternative, plaintiff must dismiss his cause under Revised Statutes 4915 before asserting his cause under Revised Statutes 4918.

Plaintiff moved to strike paragraphs 27, 28, and 29 of the supplemental answer aforesaid.

On December 8, 1947, plaintiff filed motion to dismiss under Federal Rules of Civil Procedure, Rule 12(b) 28 U.S.C.A., defendants' counterclaim for patent infringement.

After argument had and with the agreement of counsel the Court, on December 9, 1947, ordered:

1. That motion is denied as to paragraphs 28 and 29 upon express understanding of defendants' counsel that as to the subject matter of these paragraphs no further testimony, evidence or argument would be adduced, but as to the defenses raised therein defendants would rest solely on their case previously presented.

2. That motion is granted as to paragraph 27 with the understanding defendants are not to be prejudiced thereby from raising the same defense of unpatentability as to claims 5 and 6 of Etten Patent No. 2,054,970, or any reissue in any suit that may hereafter be brought by the parties for patent infringement.

3. The order, carrying the signed approval of counsel for plaintiff and defendants, further stated, "It is further understood that both parties hereto have concluded their

COPY BOUND C

respective cases as to the original and amended complaint and that no further evidence or testimony will be adduced herein in connection with the causes of action of said original and amended complaints."

At the hearing it was agreed that in the event plaintiff's motion to dismiss the counterclaim for patent infringement (paragraphs 30 to 34 of defendants' supplemental answer) were refused, the proper procedure would be to direct a separate trial which would necessitate the taking of additional testimony, and with that understanding, the case, exclusive of the counterclaim, was closed.

On December 19, 1947, plaintiff filed notice and supplemental affidavit in support of his motion to dismiss counterclaim.

On December 30, 1947, defendants filed a request to defer decision on the 4915 and 4918 actions until the status of the plaintiff, Etten, is clarified; that the Chamberlain Corporation is the party in interest, and that accordingly the absence of indispensable parties goes to the jurisdiction of the Court. In support thereof, defendants filed therewith a paper purporting to be uncertified excerpts from sworn statements of Etten in Public Use Proceedings, Nicholas L. Etten vs. Gustave H. Jantz, involving Jantz application Serial No. 749,977 (forming part of affidavit of Ralph Hammer); affidavit of Ralph Hammer; also interrogatories to plaintiff, and notice to counsel for plaintiff of the filing by defendants of the said motion and related papers.

On January 9, 1948, plaintiff filed motion to strike under Rule 12(f) defendants' notice of December 30, 1947, together with the papers referred to therein and attached thereto.

CLOSE IN CENTER

Findings of Fact.

1. The complaint, as amended, sets forth claims under Section 4915, R.S., 35 U.S.C.A. § 63 and Section 4918, R.S., 35 U.S.C.A. § 66.

2. The parties hereto had previously been involved in a series of four co-pending Patent Office Interferences, including the two here involved, Nos. 75,433 and 76,987, first declared on February 15, 1938, and April 25, 1939, respectively and two not here specifically involved, No. 77,671 and 77,672, first declared on November 8, 1939.

3. The Jantz application, Serial No. 749,977, filed on October 25, 1934, which issued after the filing of this suit into Letters Patent No. 2,406,951 on September 3, 1946, was involved in all four of these interferences. The Etten reissue application, Serial No. 167,775, was involved only in Interference No. 76,987. Etten's application, Serial No. 38,932, filed on September 3, 1935, was involved in Interference No. 75,433, which includes only a single count or claim here in suit, and was also involved in Interference No. 77,671. Etten Patent No. 2,054,970 was involved in Interference No. 77,672.

4. Interferences Nos. 77,671 and 77,672, not here in suit, were declared after October 5, 1939, and were subject to the provisions of the United States Statutes, Section 4904, R.S. and Section 4911, R.S., 35 U.S.C.A. §§ 52 and 59a, as amended on August 5, 1939, c. 451, § 3, 53 Stat. 1212, and Section 4915, R.S. as well as 4904 and 4911, R.S., since all three statutes were amended.[1]

5. Interferences Nos. 76,987 and 75,433, the four counts or claims of which are here specifically in suit, were de-

[1] The Act of August 5, 1939, became effective two months after its approval. See Footnote 35 U.S.C.A. § 52.

cleared prior to October 5, 1939, and were subject to the laws in force and effect prior to the above said amendment of the Revised Statutes 4904, 4911, and 4915.

6. By stipulations filed in the Patent Office proceedings it was agreed that depositions on behalf of Etten taken September 9, 1940, might be used in evidence as to both Interferences Nos. 75,433 and 77,671,[2] and also as to Interferences Nos. 77,987 and 77,672;[3] and that the depositions on behalf of Jantz taken October 28, and 29, 1940, might be used in all four of the above interferences.[4]

7. The Patent Office Examiner of Interferences considered the testimony before him in connection with Interferences Nos. 75,433 and 76,987 here involved, and on April 23, 1942, awarded priority to Gustave H. Jantz.

8. Interferences Nos. 77,671 and 77,672, not here involved, were not decided by the Examiner of Interferences but were decided by the newly created Board of Interference Examiners which Board, in a decision dated April 23, 1942, awarded priority to Gustave H. Jantz.

9. Nicholas L. Etten, the losing party in Patent Office Interferences Nos. 75,433 and 76,987 here involved, duly took an appeal to the Patent Office Board of Appeals and that tribunal on April 24, 1943, affirmed the decision of the Examiner of Interferences awarding priority to Gustave H. Jantz. The decision of the Board of Interference Examiners in the two companion Interferences Nos. 77,671 and 77,672 not here involved, which came under the new amended practice were not appealable to the Board of Appeals as such an appeal under the amended practice was no longer provided for, and Nicholas L. Etten, the plain-

---

[2] Plaintiff's Exhibit No. 152, Page 4.
[3] Plaintiff's Exhibit No. 153, Page 4.
[4] Plaintiff's Exhibit No. 155, Page 2, and Plaintiff's Exhibit No. 156, Page 2.

tiff herein, appealed the decisions to the Court of Customs and Patent Appeals under Section 4911 R.S. as amended.

10. The Court of Customs and Patent Appeals decided the appeals in Etten vs. Jantz, 142 F. (2d) 680, 31 C.C.P.A., Patents, 1177, Interferences Nos. 77,671 and 77,672, not here involved, on January 3, 1944, solely on the basis of the record before the Patent Office Board of Interference Examiners and affirmed that Board's award of priority in favor of Gustave H. Jantz.

11. The Patent Office Examiner of Interferences, the Board of Interference Examiners, the Board of Appeals, and the United States Court of Customs and Patent Appeals did not in the aforesaid decisions, as to any of the four interferences including the two here involved, have before them the new and additional evidence adduced by plaintiff during the trial of this case.

12. As to Interferences Nos. 75,433 and 76,987 involved in this suit, the plaintiff elected under the applicable statutes Sections 4911 and 4915, unamended, not to take an appeal as to these two interferences but instead plaintiff filed this suit in equity under Section 4915 and had a trial *de novo* before this Court.

13. The counts or claims of Interferences Nos. 75,433 and 76,987 involved in this suit under Section 4915, R.S., are directed to different inventions than the counts or claims of the two companion Interferences Nos. 77,671 and 77,672 decided by the Court of Customs and Patent Appeals; and the tribunals in the Patent Office which decided the issue in the interferences here in suit (Nos. 75,433 and 76,987) were entirely different from the tribunal that passed on the issue of the two later Interferences Nos. 77,671 and 77,672.

14. At the time of the filing of this suit, the aforesaid Jantz application, Serial No. 749,977 (now issued as Letters

Patent No. 2,406,951) was assigned to and admittedly owned by defendant Lovell, and each of the aforesaid Etten applications were owned by the plaintiff herein (Plaintiff's Exhibits Nos. 139 and 140.)

15. H. C. Lord, of Counsel for defendant, prior to the taking the Patent Office Interference testimony on behalf of the party Jantz, negotiated with the aged Jantz, now deceased, to acquire the Jantz application, and purchased the application on March 16, 1938, for defendant Lovell on an installment plan wherein the final payment of $1500.00 to Jantz was contingent upon either Jantz or Kauffman being finally adjudged to be the first inventor of the toggle release wringer.

16. The assignment from Jantz to Lovell (Plaintiff's Exhibit No. 31) was not, however, recorded until April 30, 1942, which was not only after the testimony of Jantz was taken on October 28, 1940, by and with the assistance of A. F. Herbsleb, Attorney for Jantz, whose services were retained by H. C. Lord to assist in preparing the testimony of Jantz, but actually seven days after the date of decision of the Examiner of Interference in Interferences Nos. 75,433 and 76,987, and of the Board of Interference Examiners in Interferences Nos. 77,671 and 77,672.

17. Defendants had knowledge of the plaintiff Etten's effective application filing date of December 23, 1932, prior to the filing of sworn-to preliminary statements by Jantz in the Patent Office Interference, setting forth the dates of invention on which Jantz would rely.

18. The original preliminary statement (Plaintiff's Exhibit No. 166) executed by Jantz on March 16, 1938, setting forth a date of invention of March 1, 1933, were concealed in the files of H. C. Lord, Attorney for defendants, because the dates alleged therein were subsequent to Etten's filing

date of December 23, 1932, and at no time were produced during the Patent Office Interferences.

19. While previous to this trial the records of defendants and their counsel had been produced with the statement by defendants' counsel that they were the complete records, nevertheless, defendants' counsel was still concealing and suppressing the Jantz original preliminary statements (Plaintiff's Exhibit No. 166) dated March 16, 1938; and this suppression was continued by defendants and their counsel until the last day of the trial, and the statements were even then produced only under compulsion and in an effort to avoid having Mr. Lord appear in person in response to the subpoena and the repeated requests of this Court that he appear and testify at the trial.

20. Subsequent to the execution of these original concealed statements, defendant Kauffman contacted the aged Jantz and by coercive tactics induced him to sign an amended preliminary statement setting forth earlier dates of invention.

21. The Patent Office records in connection with the interference proceedings include sworn affidavits of Gustave H. Jantz and A. F. Herbsleb (prepared and submitted by the defendants' Attorneys) positively representing that all of the records of the Corcoran Manufacturing Company had been destroyed, although various Corcoran Manufacturing Company records, including Exhibits Nos. 52 and 53, bearing dates of June 13, 1933, and November 17, 1933, were actually in the files and records of H. C. Lord, the Attorney for the defendants, and fully available at the time of the execution and filing of these false affidavits in the Patent Office.

22. Jantz's Exhibit "O" has now been conclusively shown not to have been in existence in the Spring of 1932,

as testified to in the Patent Office proceedings, but instead to have been made in 1933.

23. Plaintiff completed the inventions of the counts or claims here in suit at least as early as the Fall of 1932, at which time these inventions were reduced to practice at the plant of the Chamberlain Corporation of Waterloo, Iowa, and which culminated in the December 23, 1932, application of Etten Patent No. 2,054,970.

24. Jantz did not complete his Exhibit "O" nor reduce his inventions to practice until sometime in the month of April, 1933.

25. As between the parties to this suit, the plaintiff, Etten, is entitled to priority on the subject matter of his application for reissue, Serial No. 167,775, here in suit, and of the subject matter of his application, Serial No. 38,932, here in suit, and which subject matters include the three counts of Interference No. 76,987 and the single count of Interference No. 75,433.

26. Gustave H. Jantz Letters Patent No. 2,406,951 embraces subject matter including claims such as and like claims 2 and 13, which are in direct conflict and in interference with plaintiff's Letters Patent No. 2,054,970 (on which application for reissue Letters Patent is pending), so that as to any and all such conflicting subject matter the plaintiff is entitled to priority as between the parties to this suit.

27. The issuance of Jantz Letters Patent No. 2,406,951 assigned to the defendant, Lovell, was fraudulently procured by the defendants when they knowingly and deliberately submitted and caused to be submitted to the Patent Office false and untrue evidence and affidavits while concealing and suppressing other pertinent evidence in the files of their Attorneys, H. C. Lord and A. F. Herbsleb.

Conclusions of Law

1. The Court has jurisdiction over plaintiff's claims under Section 4915 and Section 4918.

2. This proceeding is a trial de novo in equity in which the trial court is charged with the responsibility of considering all competent evidence, new and old.

3. The burden is upon the plaintiff in this suit to prove by more than a mere preponderance of evidence that the Patent Office was in error in awarding priority of invention on all counts in Interferences Nos. 77,671 and 77,672 to Gustave H. Jantz.

4. The decisions of the Patent Office in Interferences Nos. 77,671 and 77,672 create no estoppels against the issues of the present action.

5. The decision of the Court of Customs and Patent Appeals in Interferences Nos. 77,671 and 77,672 are not res adjudicata as to the issues of the present action.

Discussions of Law.

The first question requiring decision in this cause is whether plaintiff having appealed Interferences Nos. 77,671 and 77,672 to the Court of Customs and Patent Appeals is estopped from bringing his Bill in Equity under Section 4915, Revised Statutes, as to Interferences Nos. 76,987 and 75,433. Defendants' Counsel seek to simplify the problem, stating in their brief: "The issue of fact decided by the C.C.P.A. was that Jantz Exhibit O was completed and reduced to practice at least as early as April 10, 1932. The earliest date Etten contends for is May 2, 1932. Upon these facts, Etten is obviously the second inventor and not entitled to a patent," and contend that the decision of the

Court of Customs and Patent Appeals[5] is res adjudicata of the issues here involved. They rely heavily upon Blackford v. Wilder, 28 App.D.C. 535, and Horine v. Wende, 29 App.D.C. 415. These and other cases cited[6] are not determinative of the precise question here involved.

[1] Administrative decisions under 4911, Revised Statutes by the Court of Appeals of the District of Columbia prior to 1929 and of the Court of Customs and Patent Appeals subsequent thereto, limited as they are to the record before the Patent Office, are binding only on the Commissioner of Patents, but are not binding as precedents in the regular Federal constitutional courts.[7]

The doctrine of res adjudicata announced in the Blackford and Horine cases, supra, moreover has no application to concurrent, copending or companion interferences. Under such circumstances, despite prior decisions on some of such interferences, suits under 4915, Revised Statutes have been considered on the merits.[8]

---

[5] Etten v. Jantz, 142 F.2d 680, 31 C.C.A., Patents, 1177.

[6] Defendants' Counsel cite Chase v. Coe, 74 App.D.C. 152, 122 F.2d 198; United States Rubber Co. v. Coe, 79 U.S.App.D.C. 305, 146 F.2d 315; McBride v. Coe, D.C.D.C., 50 F.Supp. 286. These cases do not involve concurrent or coperding interferences but have reference to an attempt by a party defeated in one interference to have a new interference set up with substantially the same issue.

[7] United Shoe Machinery Corp. v. Muther, 1 Cir., 288 F. 283, 285. (The court here considered an issue of priority which had previously been decided by the Court of Appeals of District of Columbia under a 4911 appeal). International Cellucotton Products Co. v. Coe, 66 App.D.C. 248, 85 F.2d 869; Novelty Glass Mfg. Co. v. Brookfield, 3 Cir., 170 F. 946, 955; Dwight v. Lloyd Sintering Co., Inc., v. Greenawalt, 2 Cir., 27 F.2d 823, 827; Tillman & Bendel v. California Packing Corp., 9 Cir., 63 F.2d 498, 503, certiorari denied 290 U.S. 638, 54 S.Ct. 55, 78 L.Ed. 554; John Morrell & Co. v. Doyle, 7 Cir., 97 F.2d 232, 235, certiorari denied 305 U.S. 643, 59 S.Ct. 146, 83 L.Ed. 415.

[8] Philadelphia Storage Battery Co. v. Zenith Radio Corp., 7 Cir., 117 F.2d. 642; Hazeltine Corp. v. Radio Corp. of America, 67 App.D.C. 373, 92 F.2d 524; Raytheon Manufacturing Co. v. General Electric Co., D.C. N.D.N.Y., 34 F.Supp. 40.

It is also pertinent to note that the Court of Customs and Patent Appeals, recognizing the difference between its jurisdiction as limited solely to a review of the Patent Office Record and the broader scope of a 4915 Revised Statute action, has refused to consider the effect of a prior decision under a 4915 Revised Statute action in a related interference.[9]

The Interferences Nos. 75,433 and 76,987 were declared on February 15, 1938, and April 25, 1939, respectively, whereas the Interferences Nos. 77,671 and 77,672 upon which the decision of the Court of Customs and Patent Appeals was predicated were not declared until November 8, 1939. It was not by reason of any action or choice of the plaintiff but because of the amendment to the Patent Laws, effective October 5, 1939, that the two later interferences traveled a separate and distinct path and were first decided. The interferences declared after October 5, 1939, were decided by the Board of Interference Examiners on the same date that the earlier interferences here involved were decided by the Examiner of Interferences.[10] These interferences (administratively separated by the Patent Office in accordance with the statute amended as aforesaid) therefore could not have been consolidated in one appeal. Interferences Nos. 75,433 and 76,987 were not ready for appeal on Bill in Equity at the time such action had to be taken on Nos. 77,671, and 77,672. Certainly it

---

[9] Meuer v. Schellenger, 104 F.2d 949, 953, 26 C.C.P.A., Patents, 1430.

[10] Section 4915, R.S., governing bills in equity to review decisions of the Patent Office, was amended concurrently with Section 4911, R.S. Prior to the amendment a condition precedent to such bill was a decision of the Board of Appeals whereas after the amendment the decision of the Board of Interference Examiners was sufficient. Lacking the requisite Board of Appeals decisions in Interferences Nos. 75,433 and 76,987 on April 23, 1942, plaintiff could not then bring bill in equity as to them even though he was forced to take action in Interferences Nos. 77,671 and 77,672, the time limit for taking appeals to the Court of Customs and Patent Appeals being 40 days. Rules of Practice, Patent Office, rule 149, 35 U.S.C.A.Appendix.

was not the intention of Congress, in changing the Patent Law, to penalize plaintiff as to the earlier interferences or to bar him from his remedies thereunder, especially since plaintiff was patentee under Interference No. 77,672 and as to such intereference had no choice, his only remedy being appeal to the Court of Customs and Patent Appeals.[11]

[2, 3] In only two of the interferences, Nos. 77,671 and 75,433, are the same patent applications involved.[12] The Board of Appeals recognizing that the interferences were separate and distinct, [13] decided the issue of priority on the merits as to the two interferences now before us., although appeals to the Court of Customs and Patent Appeals were then pending on Interferences Nos. 77,671 and 77,672. There is also a public interest involved in the present case.[14] If plaintiff is estopped it will result in defendant's retention until September 3, 1963, ten years greater than plaintiff's of a monopoly grant which plaintiff alleges was improper and fraudulently obtained.[15] It

---

[11] Preston v. White, 92 F.2d 813, 25 C.C.P.A., Patents, 701; Wettlaufer v. Robins, 2 Cir., 92 F.2d 573, certiorari denied 302 U.S. 766, 58 S.Ct. 477, 82 L.Ed. 594; Wallace & Tiernan Products, Inc. v. Pittsburgh Plate Glass Co., D.C.W.D.Pa., 57 F.Supp. 639.

[12] Interferences Nos. 77,671 and 75,433 involved matters contained in Jantz application Serial No. 749,977 and Etten application Serial No. 38,932.

[13] In accord with the general rule stated in Re Einstein, 18 C.C.P.A., Patents, 885, 46 F.2d 373.

[14] Defendant contends, "A party may not take advantage of estoppel effective against his opponent to take something from the public. In the present case the refusal of a patent to Etten will not affect the public interest and there is accordingly nothing in the Sinko, [Sinko Tool & Manufacturing Co. v. Automatic Devices Corp.] 2 Cir., 136 F.2d 186, case which precludes the use of the defense of estoppel." (Brief for Defendants, Page 34).

[15] Mercoid Corp. v. Mid-Continent Investment Co., 320 U.S. 661, 64 S.Ct. 268, 88 L.E. 376; Sinko Tool & Mfg. Co. v. Automatic Devices Corp., 2 Cir., 136 F.2d 186, and see also the comment of the Supreme Court in Hazel-Atlas Glass Co. v. Hartford Empire Co., 322 U.S. 238, 64 S.Ct. 997, 88 L.Ed. 1250 and Precision Instrument Mfg. Co. v. Automotive Maintenance Machinery Co., 324 U.S. 806, 815, 65 S.Ct. 993, 89 L.Ed. 1381.

follows therefore that defendants' motion to dismiss the 4915 action must be denied. The important question is the extent to which new evidence may be considered and the effect to be given thereto. It is well settled that a bill in equity under 4915 is "an original independent action in which the questions in issue are tried de novo upon all competent evidence new and old."[16]

[4] We are not here concerned with the doctrine that where a party intentionally withholds evidence in his possession prior to and during the interference proceedings such evidence will not be considered in the equity proceedings.[17] The distinction has been pointed out in Minnesota Mining & Mfg. Co. v. Carborundum Co., 3 Cir., 155 F.2d 746, 748.[18] There is nothing before us to indicate that any evidence was intentionally withheld by plaintiff. There is, however, every reason to believe that some of the evidence now adduced, including documents which were in its possession, was intentionally withheld by Lovell. It is true that plaintiff suspected some of it and even so indicated to the Patent Court, but it was not until the newly discovered evidence was added that the plaintiff's interpretation thereof assumed meaning and spurred the search for additional documents and oral testimony.[19] The oral testimony upon which defendants previously had prevailed becomes in effect a nullity in the light of the composite picture created by the new evidence. It is contended that the

---

[16] General Talking Pictures Corp. v. American Tri-Ergon Corp., 3 Cir., 96 F.2d 800, 812; Hoover Co. v. Coe, 325 U.S. 79, 83, 65 S.Ct. 955, 89 L.Ed. 1488; Minnesota Mining & Mfg. Co. v. Carborundum Co., 3 Cir., 155 F.2d. 746; Daniels v. Permutit Co., D.C.Del., 44 F.Supp. 74, reversed on other grounds, 3 Cir., 137 F.2d 823.

[17] Barrett Co. v. Koppers Co., 3 Cir., 22 F.2d 395; Schilling v. Schwitzer-Cummins Co., 79 U.S.App.D.C. 20, 142 F.2d 82.

[18] See also Globe-Union, Inc. v. Chicago Telephone Supply Co., 7 Cir., 103 F.2d 722, 728.

[19] Cf. Globe-Union, Inc. v. Chicago Telephone Supply Co., supra, for a situation very similar to the present case.

administrative decision supported by substantial evidence is conclusive under the doctrine of Morgan v. Daniels, 153 U.S. 120, 14 S.Ct. 772, 38 L.Ed. 657. The force and effect to be given such decision has been discussed in numerous cases.[20] The rule is stated in Minnesota Mining & Mfg. Co. v. Carborundum Co., 3 Cir., 155 F.2d 746, 748, 749, as follows: "Morgan v. Daniels states a rule of law whereby a fact question must be judged. The question therefore is whether all competent evidence, 'new' and 'old', offered to the District Court carries 'thorough conviction' that the Patent Office erred. General Talking Pictures Corp. v. American Tri-Ergon Corp., supra, at page 812 of 96 F.2d. A proceeding under R. S. Section 4915 is an anomaly. The trial in a District Court is a trial de novo. But the decision of the Patent Office may not be reversed unless the evidence before the court carries thorough conviction that the Patent Office erred. In other words, a District Court may not reverse the decision of the Patent Office on a mere preponderance of the evidence. More is required. The District Court must find that the decision of the Patent Office was without substantial basis in the evidence or was wrong as a matter of law."[21]

---

[20] Most pertinent here is the comment of the court in discussing Morgan v. Daniels, supra, and Barrett Co. v. Koppers Co., supra, in Globe-Union, Inc. v. Chicago Telephone Supply Co., supra, 103 F.2d at page 727, as follows: "The additional evidence found in the trial court's record is not merely cumulative in nature. On the contrary, it carries with it thorough conviction, and strikes hard at the core of Schellenger's evidence." See also Appert v. Brownsville Plate Glass Co., C.C.W.D.Pa., 144 F. 115; Daniels v. Permutit Co., supra.

[21] We adopt, in toto, Judge Goodrich's comment in Daniels v. Permutit Co., supra, 44 F.Supp. at page 79, in passing upon the precise question here posed: "The court has in mind the decision of Morgan v. Daniels, 1894, 153 U.S. 120, 14 S.Ct. 772, 38 L.Ed. 657, and there is no disposition to minimize the importance of the considered judgment of the experts responsible for the administration of the Patent Office. But Morgan v. Daniels clearly has no application to the conclusion reached here because the new testimony is overwhelmingly in support thereof and was not before the officials in the Patent Office who made the award from which this appeal is taken."

In addition to the 4915 action, the granting of the Jantz Patent No. 2,406,951 during the pendency of this action raised the clear issue of priority between interfering patentees since the prior granted Etten Patent No. 2,054,970 and the Jantz patent are coextensive in their scope. Claim No. 34 of the Jantz patent, except for a slight change in phraseology is identical with Claim No. 13 of the Etten patent. If this Claim No. 34 of the Jantz patent is void, then there is no occasion for a disclaimer of claim No. 13 of the Etten patent and such claim is properly before the Patent Office in the reissue application. We comment on this since Counsel for defendants have devoted considerable argument to this point under their theory of estoppel. Such argument is predicated upon the theory that Claim No. 13 was involved in Interference No. 77,672. The Court of Customs and Patent Appeals merely authorized the Commissioner of Patents to issue a patent to Jantz because on the evidence as it stood in the record of the Patent Office it found Jantz to be the first inventor. Revised Statute 4918, 35 U.S.C.A. § 66 provides: "Whenever there are interfering patents, any person interested in any one of them, * ** may have relief against the interfering patentee, * * * by suit in equity against the owners of the interfering patent; * * *." The statute further provides that the court "may adjudge and declare either or both of the patents void in whole or in part."

[5] The plaintiff, when the Jantz Patent issued, certainly became entitled to a bill in equity under 4918 with the incidental right to a trial de novo on the primary issue of priority and was entitled by his amendment to include this additional cause of action. As was stated by the Supreme Court in Triplett v. Lowell, 297 U.S. 638, 644, 56 S.Ct. 645, 648, 80 L.Ed. 949, "* * * want of disclaimer of claims previously held invalid can never be set up as a

bar in limine to the maintenance of a second suit upon those claims, and any others of the patent, since the patentee is entitled to invoke in that suit the independent judgment of the court upon the validity of the claims which have been held invalid."

Etten's claim to priority as to Claim No. 13 as against Jantz's Claim No. 34 is the very issue involved in this action. It is difficult to see how Etten could be required to first disclaim that which he is seeking to establish and vindicate in this action. Especially is this true where, as in the instant case, plaintiff contends that such subsequent patent was fraudulently obtained. As was stated in Lorenz v. Colgate-Palmolive-Peet Co., 3 Cir., 122 F.2d 875, 880: "The right of a court under R.S., Sec. 4918, to declare either or both of two interfering patents invalid 'upon any ground' seems to us to dispose adversely of the plaintiff's contention that the defendant is estopped from denying the validity of the Lorenz patent because of matter incident to or growing out of the interference proceeding in the Patent Office, * * *. Any possible estoppel of parties would be without relation to the court's power to declare a patent invalid upon sufficient showing or its duty to exercise such power in an appropriate case."

[6] In addition to the matters hereinabove referred to, plaintiff also included in his complaint an action for damages predicated upon conspiracy. In a previous ruling in this case, Judge Schoonmaker held that under Rule 18 of the Federal Rules of Civil Procedure plaintiff in his complaint could join an action for damages for conspiracy to produce false and fraudulent evidence before the Patent Office and a bill in equity under Section 4915. This ruling constitutes the law of the case.[22]

---

[22] Commercial Union of America v. Anglo-South American Bank, 2 Cir., 10 F.2d 937, 941, cited with approval in Price v. Greenway, 3 Cir., 167 F.2d 196.

Discussion of Facts

No difficulty would be experienced in arriving at the facts in this case were it not for the opinion of the Court of Customs and Patent Appeals, Etten v. Jantz, 142 F.2d 680, 31 C.C.P.A., Patents, 1177 involving Interferences Nos. 77,671 and 77,672, upon which opinion great stress has been placed by defendant.

In the proceedings before the Examiner of Interferences and the Board of Interference Examiners both parties took testimony by deposition only, which by stipulation was made applicable to all four interferences. As we have already indicated, this is a trial de novo, and the question therefore is whether all competent evidence, "new" and "old" offered herein carries "thorough conviction" that the Patent Office erred. We are of the opinion that this question must be answered in the affirmative in the following particulars.

The opinion of the Court of Customs and Patent Appeals was predicated primarily on the depositions of Gustave H. Jantz, Bernard A. Brueggeman, Joseph Dasbach, Herman Onck, Mrs. Herman Onck, and the authenticity of Jantz Exhibit "O".

The court in Etten v. Jantz, supra [142 F.2d 683], conceded that where the usual records are absent the oral testimony [23] must be scrutinized, but concluded that it found "nothing in the record impugning the credibility of said corroborating witnesses." This testimony was dependent upon the authenticity of and time element involved as to the alleged first completed wringer (Jantz Exhibit "O", Patent Office) as to which considerable emphasis was placed on a change from keyhole slots to round holes, pursuant to an infringement notice, which was stressed as

[23] All testimony was by deposition.

fixing a date prior to which this Exhibit "O" had been completed. That court did not have before it facts now revealed which present an entirely different picture. As to the physical Exhibit "O", the testimony of Jantz in the deposition taken in October 1940, under the questioning by Attorney Lord, would give the impression that at the time the question of evidence for the Patent Office first arose this wringer was produced immediately by Jantz.[24] It now appears, from the defendant's own records, known to Attorneys Lord and Herbsleb at the time but not revealed,[25] that at the time of Jantz's first preliminary statement of March 16, 1938,[26] Jantz had not mentioned or produced this wringer.

---

[24] Plaintiff's Exhibit No. 155, Pages 21, 22, Questions and Answers 95, 96:

"Q95. How did you come to have this exhibit,—will you tell us where it came from, and how you came to get it for this case? A. All of it, or what?

"Q96. Where was it after it was made,—where was it put? A. After it was made it was kept awhile, and then I took it out and showed it and then brought it back to the factory, and when it was decided that the Corcoran Company would quit business and sell out, I gathered up a certain number of wringers of different makes and ours, this included, because I wanted it as a sort of, you might say, keepsake, and I put all of those things in one corner of the factory floor, and put a card on it,—property of G. H. Jantz. And then, later on, as things were being moved out of the factory by the people that had bought those articles, I had a truck take all of these old wringers and stuff, all I had put in the corner, and sent it down to the Boss Washing Machinery Company, who very kindly allowed me to put it in a corner down there in one of their factory rooms, and when this matter came up, and I wanted something, I went down there to the Boss Washing Machine Company and picked us some things, and among them I picked up this wringer."

[25] Nor was it revealed at that time that Attorney Lord was actually acting on behalf of Lovell, the then assignee thereof, which assignment was not however placed on record, nor that Herbsleb was being paid by Lovell. Throughout there was a careful plan manifest to give the impression that it was solely a battle by the elderly Jantz.

[26] Plaintiff's Exhibit No. 166. In this preliminary statement Jantz fixed April 10, 1933, as the date when the machine was first successfully operated. Lovell, through Lord and Herbsleb, had succeeded in substituting an amended statement with the earlier date of completion. It was not at that time revealed that several other statements had been prepared for and by Jantz fixing intermediate stepped-up dates. This first statement was finally produced by Counsel for defendants in the present proceedings, but most reluctantly on the last day of the hearings.

On the contrary, Brueggeman, one of the corroborating witnesses, sometime prior to April 30, 1938, had turned over to Mr. Jantz what was then thought to be the "first Jantz Toggle Wringer" that was made. This was the statement of Herbsleb to Lord in a letter of April 30, 1938.[27] It was later discovered that this wringer was made of production parts[28] for which the dies were not in existence until sometime after September 21, 1933.[28½] Although, according to Herbsleb, Jantz and Brueggeman both told him it was the first wringer and he himself ascertained that it could not be sustained as such,[29] nevertheless, in spite of such developments, Herbsleb now contends that Jantz finally in December 1939, produced Exhibit "O", and that he asked Jantz for no explanation.[30] It is significant that this occurred after a meeting between Lord, Herbsleb, Kauffman, Jantz, and Brueggeman.[31] Under such circum-

---

[27] Plaintiff's Exhibit No. 27a.

"Mr. Brueggeman also turned over to Mr. Jantz the first Jantz Toggle Wringer that was made, and I have had some photographs made of it.

* * * * * *

"Mr. Brueggeman states that this first wringer was begun on or about the 1st of June, 1932, and completed and successfully operated on or about the 1st day of December, 1932. He said this first wringer was used at that time in actually wringing clothes, and that it operated successfully."

[28] Herbsleb now admits that the first time he saw or had any knowledge of Exhibit "O" was in December 1939 (Plaintiff's Exhibit No. 135—Testimony of Herbsleb—Question 204 et seq.), although prior to December 1939, he spent considerable time with Jantz, Brueggeman, and others (Plaintiff's Exhibit No. 135—Testimony of Herbsleb—Question 280, and his various reports to Lord).

[28½] Plaintiff's Exhibits Nos. 54 and 55 (A—I) (Order and quotations for Dies).

[29] Plaintiff's Exhibit No. 135—Herbsleb's testimony, Questions 225, 226, 227.

[30] Plaintiff's Exhibit No. 135—Herbsleb's testimony, Question 218.

[31] Plaintiff's Exhibit No. 135—Herbsleb's testimony, Questions 276-281 and cf. as to time element and activities thereafter. Herbsleb's letter and memo of December 16, 1939 (Contained in Plaintiff's Exhibit No. 27b).

stances, Jantz in his deposition, made in accord with a memorandum previously prepared for him,[32] testified as though it was his personal knowledge as to matters concerning which he had never had any doubt and as to which he had never had any occasion to change his story. The evidence now adduced presents an entirely different picture. In their brief for Jantz[33] before the Board of Appeals, Lord and Herbsleb[34] stressed the authenticity of Exhibit "O", and the evidence to the effect that Exhibit "O" was the first wringer; that immediately thereafter a second wringer was made, while parts of Exhibit "O" were being plated; that they were made with keyhole slots, and that a Notice of Interference as to keyhole slots given to Corcoran Mfg. Company by Lovell on June 17, 1932,[35] was intended to establish that such wringers were made prior thereto;[36] and that the base with keyhole slots was removed and a base with round holes introduced but that the uprights were in the original wringer.[37] Using the original infringement notice as to the keyhole slots as a basis for giving credibility to the testimony of the witnesses as to dates prior to June 1932, Lord and Herbsleb, although they elicited such testimony from the witnesses,[38]

---

[32] See Herbsleb's letter of October 17, 1940, and accompanying memo (Plaintiff's Exhibit No. 27c).

[33] Brief for Gustave H. Jantz in the United States Patent Office, before the Board of Appeals, Pages 22-32.

[34] Actually at that time representing the present defendant Lovell, the unrevealed assignee (e. g. See Herbsleb's letter to Lord, dated November 5, 1940—Plaintiff's Exhibit No. 92).

[35] Jantz Patent Office Exhibit "K".

[36] Brief for Gustave H. Jantz in the United States Patent Office, before the Board of Appeals, Page 30.

[37] Brief for Gustave H. Jantz in the United States Patent Office, before the Board of Appeals, Page 28.

[38] The correspondence indicates that Lord originated the idea of using the June, 1932, letter at one of the conferences with witnesses (e. g. Letters of December 7, 9, and 19, 1939, Plaintiff's Exhibit No. 27b).

never referred to or revealed the correspondence between themselves,[39] which followed this infringement notice, and which now shows that no final determination was reached and the arrangements for such a change not made until after the receiver was appointed[40] and until some unknown time after Herbsleb's letter of October 10, 1932.[41] Climaxing all this is the conclusive proof now before this Court that the entire frame of Exhibit "O" was not in existence until after such change had been made as to the preceding wringer models, and that the bottom bar on such frame never had been changed from a keyhole slot to a round hole. Such bottom bar never was removed and such frame must have been made after the change in production to a frame with round holes in the base.[42]

The other method used by the witnesses in the depositions in the Patent Office proceeding to tie in Exhibit "O" with the other occurences was the contention that Exhibit "O" had certain parts plated and such plating was done by one Al Yaegers, while the second or duplicate wringer was being made immediately after Exhibit "O" had been completed.[43] Evidence now adduced proves convincingly

---

[39] e. g. Plaintiff's Exhibits Nos. 56, 57, 58, 95, and 96.

[40] Receiver was appointed September 1932. Lord wrote to the Receiver on October 3, 1932 (Plaintiff's Exhibit 96).

[41] Plaintiff's Exhibit No. 95, and see also Plaintiff's Exhibit No. 135—Herbsleb's testimony, Questions 165 to 182 inclusive, and the exhibits referred to therein.

[42] Transcript of Proceedings at Erie, Pennsylvania, October 21-23, 1946. Testimony (Page 141 et seq.) of C. Weston Steward, an expert on welding, that such wringer frame was never rebuilt or changed.

[43] Plaintiff's Exhibit No. 155, Pages 97 and 102, Dasbach in his deposition testified:

"Q196. The one that you kept, was that the first one you made, which is the one plated, was that the first or some of the others? A. The one that was plated, it was the first.

"Q197. How did you come to make the second one after the first one, do you remember anything about that? A. Well, the plater that

(Continued on p. 26a)

that this actually occurred in April 1933,[44] and affirms the irresistible conclusion that Exhibit "O" was not completed and in existence until that year. This conclusion is also in accord with the uninfluenced sworn first preliminary statement of Jantz[45] that the wringer was completed and first successfully operated about April 10, 1933. It is also in accord with a letter Jantz wrote on February 19, 1938, to the Lovell Mfg. Co.,[46] and again on February 22, 1938,

---

(Footnote 43—Continued)
worked for Corcoran, he was located downtown,—they took, after I had the parts all tried out,—we took those parts they had to be plated, to the plater, and while they was at the platers' I started to work on the parts for the second one. By the time they come back for assembling, I had them pretty near ready, and I could compare them with the parts that was made first; at the same time we kept the frame and I tried those parts I made out in the frame.

* * * * * *

"XQ247. You said when you made this original Jantz Exhibit O, that the original parts which you identify as now present on Jantz Exhibit O, were taken to the plater to be plated, as they now appear? A. Yes.

* * * * * *

"XQ253. Well, these particular parts were plated at some particular time, were they not? A. Well, they was plated in 1932."

Cf. Brief for Gustave H. Jantz submitted by Lord and Herbsleb before the Board of Patent Appeals, United States Patent Office (Pages 25, 26).

[44] Transcript of Proceedings at Erie, Pennsylvania, October 21-23, 1946. Testimony of Aloysius H. Yaegers, Page 104 et seq.

[45] Plaintiff's Exhibit No. 166—Jantz's first preliminary statement which was sent by Herbsleb (in letter of March 16, 1938, in Plaintiff's Exhibit No. 27a) to Lord, not known to the Patent Office and reluctantly produced on the last day of the present trial.

[46] Plaintiff's Exhibit No. 10. In this letter to Lovell Mfg. Co. Jantz stated:

"Not long after the first sample wringer equipped with toggel-lever device was finished I showed it to Nineteen Hundred Corp. who gave me an order June 20, 1933. As the dies for production had not been made, nor even started on, because I wanted to find out first whether or not the Trade would buy this wringer, immediate shipment could not be made."

to Lord,[47] and reaffirmed in a letter to Lord on March 3, 1938.[48]

Kauffman, on behalf of Lovell Mfg. Co., then interviewed Jantz. Kauffman's report to Lord on April 15, 1938, is illuminating.[49] In spite of the fact that Kauffman himself took a production wringer and in a few weeks developed a toggle release for it shortly after Jantz had visited him in June 1933,[50] and in spite of the fact that Jantz "* * * steadfastly maintained that it was only a matter of a couple of months from the first conception of the invention until they had a sample and took orders from Nineteen Hundred ",[51] and in the face of the fact that Jantz insisted he

---

[47] Plaintiff's Exhibit No. 12. In Jantz's letter to Lord he stated:

"The sample Toggel-lever wringer which I showed June 20, 1933 I think, was talked about, off and on, during it's construction about thirty day previous to June 20, * * *."

[48] Plaintiff's Exhibit No. 17. Jantz wrote:

"The two release bars came as a suggestion from a wringer which was so constructed, and which I had obtained from a W.M.M. and brought to the factory, for the purpose of figuring to make it.

* * * * * *

"The four different models which were being manufactured were made according to my directions and approval, so the toggel-lever lock was constructed more or less according to my directions, and when I approved it a sample wringer was finished, which I took on a trip to show and find out what the W.M.M. would say about it, so as to decide whether or not we would be justified to go into production of the wringer.

"I believe the first W.M.M., at least one of the first, I showed this wringer to was the Nineteen Hundred Corp. June 20, 1933 according to their order, therefore I judge that it must have been about a month previous to this date when the toggel-lever device was first mentioned, of course I thoroughly tested the wringer before I took it on the trip."

[49] Plaintiff's Exhibit No. 14.

[50] Plaintiff's Exhibit No. 134, Page 68.

[51] Plaintiff's Exhibit No. 14—Kauffman's report to Lovell Mfg. Co. of interview with Jantz.

had obtained the idea from the Voss Wringer,[52] Kauffman exerted extreme pressure on the aged Jantz[53] attempting to convince him that it must have taken from a year to a year and a half.[54] Kauffman also knew that Jantz was in straightened financial circumstances and hopeful of getting employment with Lovell Manufacturing Company[55] to whom he had assigned his patent application, with a balance of $1500 dependent upon a successful outcome of such proceedings.[56] The effort was to get Jantz to make a

---

[52] Plaintiff's Exhibit No. 14—Kauffman's report to Lovell Manufacturing Company of interview with Jantz.

"One toher thing that was discussed at some length was that Jantz had frequent contacts with Walter Voss at the Voss plant about the inverted U type release bar. Jantz said that he got this proposition of having one of those bars on either side of the wringer from Voss, and had gone ahead and made up a model using this mechanism on the Corcoran wringer * * *. He stated that one of the reasons why he didn't think it took them long to work up the toggle job was that he already had the release bar part of it done due to his work on the Voss-Chamberlain wringer and that he therefore had only to invent a new release mechanism, that is, the toggle, in order to complete it."

[53] Although Jantz was actually 82 years of age (Plaintiff's Exhibit No. 51) Jantz in his deposition, under the questioning of Lord, gave his age as 65. (Plaintiff's Exhibit No. 156, Jantz Deposition, Question 1.)

[54] Plaintiff's Exhibit No. 14—Kauffman's report of April 15, 1938, covering the meeting on Good Friday states:

"I argued with him that on the face of it this didn't look right to us because our experience was that it took from a year to a year and a half, rather than just two or three months, to get this much accomplished. Jantz wouldn't budge an inch for a couple of hours under more or less a third degree from me. I understand this was the position he took when he was in Erie and he seemed to have his mind stubbornly shut on the subject."

[55] Plaintiff's Exhibit No. 14—Kauffman's report.

"He seems very kindly disposed toward the Lovell Company in every way although quite downcast that we weren't taking him back to work and professed to be still hopeful that Mr. A. M. Doll would some day give him another opening. I evaded this question entirely."

Also in the report "I gathered from all appearances that Jantz is in pretty straightened financial circumstances, terribly distressed and worried and pretty wobbly in every way."

[56] Plaintiff's Exhibit No. 26. This assignment was not revealed during the Patent Office proceeding. The depositions gave the impression that it was an unaided effort by the elderly Jantz himself.

preliminary statement giving a date antedating the Etten date.[57]

What occurred between April 30, 1938, and May 3, 1938, leaves much to the imagination, but it is clear that on May 3, 1938, Jantz again executed a sworn preliminary statement in which the date of conception was stepped up to April 1, 1932, and date of completion to September 1, 1932.[58] This is the preliminary statement which was filed to meet the time limit of May 6, 1938, and subsequently, before opening thereof in the Patent Office, replaced by the sworn final preliminary statement of January 2, 1940.[59] As to the methods used to obtain the substitution of this statement, it it pertinent to note that Herbsleb made an affidavit[60] in which he states that Jantz did the investigating and report-

---

[57] Kauffman, Chief Engineer of the Lovell Manufacturing Company, at that time knew the Etten **filing date** of December 23, 1932, and was striving to get Jantz, by intermediate stages, to step up the dates. In his report (Plaintiff's Exhibit No. 14) Kauffman stated: "I took him over to the Church to the noonday services to try and break up the deadlock in his thinking. It did some good for after Church, and resting his mind a bit he decided that it might have been as early as January, 1933 when he first thought of the toggle device. This did not seem like much gain, but it was so hard fought that I didn't want to lose it, so I called up Herschlerb and took Jantz up there to make up new preliminary statements."

(Note) This second known preliminary sworn statement also was suppressed and was never used, but is again mentioned in Herbsleb's letter to Lord of April 23, 1938 (In Plaintiff's Exhibit No. 27a) and the same dates repeated in his letter of April 30, 1938 (In Plaintiff's Exhibit No. 27a) in which letter he also states: "Mr. Brueggeman states that this first wringer was begun on or about the 1st of June, 1932, and completed and successfully operated on or about the 1st of December, 1932. He said this first wringer was used at that time in actually wringing clothes, and that it operated successfully." This is the wringer which was made from parts produced from dies which were not in existence until sometime after September 21, 1933 (Plaintiff's Exhibit No. 54).

[58] Herbsleb's letter to Lord, dated May 3, 1938 (In Plaintiff's Exhibit No. 27a and Plaintiff's Exhibit No. 145).

[59] Plaintiff's Exhibit No. 146.

[60] Part of the Renewal of Motion For Leave to File Substitute Preliminary Statement, Plaintiff's Exhibit No. 150.

ed to him,[61] and that the statement of Jantz as to the destruction of the records of the Corcoran Company as to such wringers was to the best of his knowledge true.[62] Against this affidavit appears the correspondence between Herbsleb and Lord and Herbsleb's memoranda made during the intervening period which shows conclusively that Herbsleb directed the investigation and did a great deal of the interviewing himself; knew that Brueggeman had turned over to him some pertinent office records (which will be touched upon later) and records as to the Modern Tool Co. in connection with the dies for production of the wringer, in fact, had sent them personally to Lord who kept them, unrevealed, in his files, and knew that such records, although pertinent, had not been shown to the witnesses whose recollection might have been aided thereby. As to the Examiner's statement in allowing the substitution that "Jantz did not at the time of his motion know what dates Etten was urging and therefore the motion should not be summarily denied," Herbsleb and Lord in their brief before the Board of Appeals stated: "Further, there is no suggestion that Jantz's counsel (Herbsleb) at the date the original statement was made had any knowledge of this prior testimony, and *nothing to indicate the communication of any* knowledge that the *later associate* attorney might have to Jantz." (Emphasis supplied.) This has an ironic ring in view of the fact that the Lovell Manufacturing Company was the unrevealed real party in interest; that Lord was their Attorney; that Herbsleb was actually employed by Lord throughout, was being paid by the Lovell Manufacturing Company; and that their correspondence shows they were making every effort to ascertain Etten's dates

---

[61] E. g. (Plaintiff's Exhibit No. 150) "Affiant thereupon requested the party Jantz to diligently re-investigate * * *, and that as the result of such re-investigation, the party Jantz supplied affiant with the dates and information contained in the substitute preliminary statement * * *."

[62] Plaintiff's Exhibit No. 150 (Affidavit of Herbsleb contained therein).

and that as their knowledge thereof increased, their efforts to step-up Jantz's dates increased[63] and in doing so avoided the use of records which they knew might have an adverse effect. This is true as to further proof of Exhibit "O's" 1933 origin given by Louis M. Ellebrecht, who was Purchasing Agent and somewhat of a General Supervisor at the Corcoran Manufacturing Company. Herbsleb contacted Ellebrecht[64] prior to the taking of the Patent Office depositions, and although he had in his possession the two Corcoran Company records which Brueggeman had turned over to him and which clearly showed Ellebrecht as a participant in certain phases of the Model "T" wringer development,[65] did not show them to Ellebrecht.[66] If further proof were needed that the Model "T" wringer was not developed until 1933, it is convincingly supplied by Ellebrecht's tes-

---

[63] E. g. Lord's letter to Herbsleb, dated September 13, 1938, (In Plaintiff's Exhibit No. 27a); Lord's letter to Herbsleb, dated January 2, 1940 (In Plaintiff's Exhibit No. 27c); Herbsleb's letter to Lord, dated February 29, 1940 (In Plaintiff's Exhibit 27c); Kauffman's Testimony (Plaintiff's Exhibit No. 134, Page 44, et seq.). Kauffman and Lord were in the Etten v. Kauffman trial on October 5, 1939.

[64] Ellebrecht's testimony (testimony at Erie Trial, October 21-23, 1946, at Page 79) as to this is confirmed by Herbsleb's own notes (e. g. Memo of May 29, 1940, Plaintiff's Exhibit No. 27c, in which appears "He said that * * * he had no means of fixing the dates, * * *").

[65] Plaintiff's Exhibit No. 53. Inter-office Memorandum from Ellebrecht to Brueggeman dated June 13, 1933, which stated:

"If it is possible, I would like to have prints on the new parts for the Model 'T' Wringer sample of which Mr. Jantz took out yesterday.

"All these parts should be lined up and be all set to go if Mr. Jantz does secure any orders for this type of wringer."

Plaintiff's Exhibit No. 52. Memorandum to Brueggeman and Ellebrecht, dated November 17, 1933, which stated, inter alia: "Now that we have the Model T. Wringer completed, the first thing we ought to do is to get up a complete Parts List of all parts."

[66] Transcript of Proceedings at Erie, Pennsylvania, October 21-23, 1946, Ellebrecht's testimony, Pages 79 and 80, in which he further states: "If he had showed me those memorandums at that time, I probably could have given him some more definite information; * * * he asked for dates at that time * * *."

timony,[67] which dovetails with Jantz's original "unassisted" recollection and with the now available additional facts and records. It is also confirmed by the testimony of Mrs. Blanche Schneider Patzhold.[68] Further confirmation of the completion of the wringer in 1933 is found in the testimony of Anthony Busam, a tool die maker, who took care of large dies and general machinery repair at Corcoran Manufacturing Company. He was interviewed by Herbsleb in 1940,[69]

---

[67] Transcript of Proceedings at Erie, Pennsylvania, October 21-23, 1946. Ellebrecht testified that they continued experimenting until they developed the Toggle release (Page 72); that they were working under receivership (which was after September 1932) and desperately needed something different (Page 73); that he placed the order in September 1933, with Modern Tool Co. for the dies for production (Page 74); that the Model "T" wringer was actually completed about June 1933, (Page 74) when the wringer was set up on a washing machine and tested (Page 74) and that "We put it on the machine and it seemed to work satisfactorily, and it was so different, and Mr. Jantz was so anxious to get out with it that—well, it was just a rush job getting it completed and painted and certain parts plated and everything ready so Mr. Jantz could rush out with this model in order to get the business. You see, he was just as anxious to get this business as we were, because while we were in receivership and financial difficulties, he was,— * * * in financial difficulties himself, * * *." (Pages 74, 75); that Al Yaeger did the plating (Pages 75 and 80); that they pushed Al Yaeger to get the plating done "* * * because we were that anxious to get Mr. Jantz on the road with that sample." (Page 80); that there were no unnecessary delays, the breaking down of the "big press" at that time being considered quite a blow (Page 89) and confirmed Yaegers' Testimony as to starting in business at the end of 1932 (Page 90); and that there was no question about getting money to start production (Page 94); and the further fact that the Corcoran inventory which he took at the time of the receivership did not include a wringer corresponding with Exhibit "O".

[68] Plaintiff's Exhibit No. 137. Testimony of Mrs. Blanche Schneider Patzhold (employed at Corcoran as receptionist, typist, etc.) that the Model "T" was completed in 1933 (Page 59), definitely after the receivership commenced (Pages 57, 59, and 63). She was called to a conference in 1940 at which Herbsleb, Jantz, Brueggeman and others from "the factory" were present, but she was not called as a witness in the Patent Office proceedings (Page 61).

[69] Plaintiff's Exhibit No. 137. Testimony of Anthony Busam (Page 25).

but not shown the Corcoran records nor the wringer,[70] and was not called as a witness.[71]

A further recital of additional details now revealing the true picture would serve no further purpose. It is now clearly apparent that Jantz knew and that the fact was that his Toggle Release Wringer (Exhibit "O") was not completed and reduced to practice until sometime in March or April 1933. The concealment of material records and knowledge on the part of Herbsleb, Lord, and Kauffman; the use of records out of context, as in the use of the infringement notice of June 17, 1932, in the face of the remaining correspondence in their files giving an entirely different time element to that event, and the personal knowledge of Lord and Herbsleb concerning the same; the now quite evident pressure brought upon Jantz, an aged man of 82 rather than the age of 65 given in his deposition; the advantage taken of his straightened circumstances; the false picture given by the concealment of the true party in interest; the eliciting of statements in the depositions of witnesses which in the light of their own personal knowledge they must have known were not true, present a sordid picture.

A brief comment on the depositions of the corroborating witnesses in the Patent Office proceeding may be in order. Jantz in his deposition had stated that the frame was first made with the keyhole slot; that they made another lower

[70] Plaintiff's Exhibit No. 137. Testimony of Anthony Busam (Pages 28, 30, and 31).

[71] Plaintiff's Exhibit No. 137. Testimony of Anthony Busam. Busam saw Dasbach working on the development of this wringer, the first time, in 1933 (Page 23). Busam was at the time repairing the "big fender draw press" referred to by Ellebrecht (Page 15); described Al Yaeger as the plater of the handle (Page 25) and that "They took it (the wringer) up and they Ducoed it and Jantz took it on the car and away he went" (Page 24).

section of this frame with round holes, and put in that section.[72] It is now known that Exhibit "O" was never so changed. It is now known that this wringer was not made until 1933. Brueggeman likewise knew that a change from keyhole to round hole in the general manufacturing of wringers had been made and also used it as fixing a date prior to which certain events occurred, but he was shown by Lord and Herbsleb only the letter of June 1932, not their subsequent correspondence, so that he would use that date to refresh his recollection as to the time of change. It now appears such change was not made until after the receivership. Furthermore, Lord and Herbsleb were Counsel at the taking of depositions and avoided any reference to the Corcoran records he had turned over to them. His testimony gave the impression that it was his original personal recollection. It gave no intimation that he had produced a wringer made of production parts and claimed it to be the original, or that he had changed and stepped up his dates from those he originally gave. He was asked about the Voss advertisement appearing in the June 1932 issue of the Electrical Merchandising Magazine, which was used as a focal point in fixing the stepped-up dates.[73] In the light of what is now known, an analysis of Jantz's deposition shows that his recollection of that advertisement was with reference to the three sided or U-shaped release for which Jantz already had a patent, and which appeared in the Voss picture. Brueggeman now admits he did not know whether the ad showed a toggle release, in fact, could not see the mechanism; that the event had reference to the three sided release bar on which Jantz already had a patent,

---

[72] Plaintiff's Exhibit No. 155. Jantz's Deposition (XQ. 285).

[73] Plaintiff's Exhibit No. 155. Brueggeman Deposition (Q. 126). This was also a material factor in his affidavit which accompanied the application to substitute the later preliminary statement.

which he had shown around the shop; that it had no bearing at all on this toggle lever release.[74]

In view of the general indication throughout the evidence that there was continuous experimentation, it is unbelievable that Jantz, with a patent issued in 1931, on a three sided release bar, had not tried it out on some of the earlier wringers. The advertisement incident no doubt occurred with some comment on Voss coming out with a three sided release bar but not as to the toggle release development, nor as to Exhibit "O". Brueggeman now denies a great many things he stated in the affidavit[75] signed by him in connection with the substituted preliminary statement,[76] and finally admits that he might be a year off on his date. He stated: "I'm afraid that's what the trouble might be."[77]

Dasbach's deposition gave the impression that his testimony was his own recollection, uninfluenced and unrehearsed. He testified that he had first seen the drawings of the wringer development, had first talked to Herbsleb that morning, in fact that he had not talked with anybody about the case before that morning.[78] Herbsleb and Lord permitted him to so testify knowing (as their records now conclusively show) that Dasbach, as he now admits,[79] had been present at numerous conferences with Herbsleb, Lord, Jantz, and Kauffman. A built-up story was thus given the appearance of a fresh uninfluenced original recollection that would have great bearing on credibility. In his deposition he fixed the time by the fact that two accidents hap-

---

[74] Plaintiff's Exhibit No. 137. Brueggeman's Testimony (Q. 429 et seq.).
[75] Plaintiff's Exhibit No. 150.
[76] Plaintiff's Exhibit No. 137. Brueggeman's Testimony (Q. 385 et seq.).
[77] Plaintiff's Exhibit No. 137. Brueggeman's Testimony (Q. 545).
[78] Plaintiff's Exhibit No. 155. Dasbach's Deposition (Q. 279 et seq.).
[79] Plaintiff's Exhibit No. 137. Joseph Dasbach's Testimony (Q. 184, Page 107, et seq.).

pened on the same day and that he was working on the wringer.[80] Yet he now reluctantly admits that he was working on a wringer at another time when two accidents occurred, in one of which he himself was injured, but he cannot state what model wringer.[81] He admits now that he could not state the model he was working on at the time of the accident mentioned in his deposition,[82] and to the question "You mean on this Exhibit O here, this one that is painted green?" answered "Oh, I couldn't tell. I was working on a handle. I didn't have the rest of it." The analysis could continue, but suffice it to say that Dasbach's deposition in the light of the cold facts now known clearly becomes worthless.

The depositions of Herman Onck and his wife and the date of April 10, 1932, fixed by the "Cat" date, were important factors in the Patent Office proceedings, and were tied in with the Exhibit "O" which was non existent on April 10, 1932. April 10, 1932, was a Sunday. Both Mr. and Mrs. Onck now admit they did not go to the factory on a Sunday.[83] They have given no satisfactory explanation. Virginia Morris, who made the "Cat" entries, confirms the entry as having been given to her by the Oncks and not a guess, as was the case in some other entries where a question mark or other notation appears.[84] Her testimony and the "Cat" record also shows that "Sudie" had other litters,

---

[80] Plaintiff's Exhibit No. 155. Dasbach's Deposition (Q. 138, Page 90, et seq.).

[81] Plaintiff's Exhibit No. 137. Testimony of Joseph Dasbach (Q. 237, Page 115, et seq.).

[82] Plaintiff's Exhibit No. 137. Testimony of Joseph Dasbach (Q. 242, Page 115, et seq.).

[83] Plaintiff's Exhibit No. 136. Testimony of Herman Onck (Q. 135, et seq.).
Plaintiff's Exhibit No. 136. Testimony of Mrs. Sara Onck (Q. 26, et seq.).

[84] Plaintiff's Exhibit No. 137. Testimony of Virginia Morris (At Page 70, Q. 6, et seq.).

one as late as September 1933. Mrs. Onck now admits she never did the washing, was not particularly interested in washing machines.[85] She thought Exhibit "O" was the wringer she saw because it had the bar on the front. She is not even sure now that the one she saw had a bar.[86]

In view of the fact that the three sided bar release was patented by Jantz in 1931, and that Jantz must have tried this out in some form or other during the course of experimentation, and in view of the fact that tests such as were made with Exhibit "O" were frequently made, as various changes were made on the wringers, it is quite possible that she did see a wringer tried out with a bar in front which to her gave it the appearance of Exhibit "O," but we now know it was not the toggle release wringer Exhibit "O" which she identified in her deposition.

Onck in his deposition gave the impression that he was called on the telephone and gave such detailed information that he was asked to come to Cincinnati, did so, discussed the nature of the testimony, and then appeared to testify.[87] When asked whether Dasbach was present, he gave answers which would leave the impression that he had not been concerned about the other witnesses.[88] He now admits that Herbsleb told him there were no Corcoran Company records;[89] that he discussed the matter with Dasbach in detail to find out what he could to tie to dates.[90] He was present

---

[85] Plaintiff's Exhibit No. 136. . Testimony of Mrs. Sara Onck. (Q. 61).

[86] Plaintiff's Exhibit No. 136. Testimony of Mrs. Sara Onck. (Q. 67-73).

[87] Plaintiff's Exhibit No. 155. Herman Onck's Deposition (XQ. 188 et seq.).

[88] Plaintiff's Exhibit No. 155. Herman Onck's Deposition (XQ 200 et seq.).

[89] Plaintiff's Exhibit No. 136. Herman Onck's Testimony. (Q. 419 et seq., and Q. 152).

[90] Plaintiff's Exhibit No. 136. Herman Onck's Testimony (Q. 325 et seq., and Q. 52 et seq.).

at two supper meetings where most of the witnesses and possible witnesses were present[91] and with Kauffman present at least at one such meeting.[92] He went to Dasbach's home a number of times while assisting in the investigation.[93] There is a conflict as to whether Onck arranged to see the other witnesses[94] or whether Herbsleb did.[95] His only interest was to do the investigating work and get paid for it.[96] He considered that he was working for Herbsleb.[97] Herbsleb never showed him Jantz's earlier statement.[98] In searching for material he was aided by Herbsleb and Brueggeman.[99] He worked with Brueggeman to build up the case even though he now admits that he and Brueggeman "• • • didn't get along so hot."[100]

It is important to note the effort that was made to find some event that occurred in the Spring of 1932 which could be used as a tie-in date and which resulted in the unfortunate choice of April 10, 1932. "Sudie's" one offspring was given a special "build-up." In explaining why that particular cat was outstanding he stated, " 'Sudie' was not merely a beautiful animal, but the father of the cat was 'Bobby Cresco'; 'Bobby Cresco' was the father of 'Bobby Shafto'."[101] Yet as to another cat "Pee Wee," a regis-

---

[91] Plaintiff's Exhibit No. 136. Herman Onck's Testimony (Q. 333 et seq.).
[92] Plaintiff's Exhibit No. 136 Herman Onck's Testimony (Q. 89).
[93] Plaintiff's Exhibit No. 136. Herman Onck's Testimony (Q. 341 et seq.).
[94] Plaintiff's Exhibit No. 136. Herman Onck's Testimony (Q. 358 et seq.).
[95] Plaintiff's Exhibit No. 27c. Herbsleb's letter to Lord dated October 10, 1940.
[96] Plaintiff's Exhibit No. 136. Herman Onck's Testimony (Q. 391 and Q. 25 to Q. 36 inc.).
[97] Plaintiff's Exhibit No. 136. Herman Onck's Testimony (Q. 380 et seq.).
[98] Plaintiff's Exhibit No. 136. Herman Onck's Testimony (Q. 392).
[99] Plaintiff's Exhibit No. 136. Herman Onck's Testimony (Q. 52 et seq.).
[100] Plaintiff's Exhibit No. 136. Herman Onck's Testimony (Q. 156).
[101] Plaintiff's Exhibit No. 136. Herman Onck's Testimony (Q. 215).

tered cat with full pedigree, also with "Bobby Cresco" as the father and born to "Sudie" on August 20, 1932,[102] he referred to it as "a little stray cat that we picked up."[103]

The above analysis of the false impression given by the deposition of Onck could be multiplied. It no longer appears as the disinterested unassisted statement of a disinterested person who was called on the telephone and then was called in shortly thereafter to testify.

All of the evidence before the Patent Office thus reviewed in the light of the new evidence now obtained, both in character and amount, carries thorough conviction that there was an arbitrary stepping-up of the Jantz date by one year; that when Jantz originally insisted on April 10, 1933, instead of April 10, 1932, he had some reason for stating that specific date and was correct. It now appears convincingly that there was a deliberate effort on Kauffman's part to step-up the date to antedate Etten's without regard to actual fact, and that Herbsleb and Lord kept unrevealed a great many factors, known to them, which they must have known would entirely alter the picture. No longer can it be said "We find nothing in the record impugning the credibility of said corroborating witnesses. * * *."[104]

Summary

[7] That there was a deliberate effort on the part of Lord, Herbsleb, and Kauffman to step-up the Jantz date of invention and reduction to practice on behalf of Lovell Manufacturing Company without regard to the truth thereof, is

---

[102] Plaintiff's Exhibit No. 103.

[103] Plaintiff's Exhibit No. 136. Herman Onck's Testimony.

"Q214 Now then, when you bred your cat later in 1932 the second time, you had a very famous offspring named 'Pee Wee', didn't you? Don't you remember 'Pee Wee'? A. No, that was just a little stray cat that we picked up; in fact, I don't recollect much of that name 'Pee Wee'."

[104] Etten v. Jantz, 142 F.2d 680, 683, 31 C.C.P.A., Patents, 1177.

apparent throughout these proceedings and certainly must be characterized as fraud in connection with the obtaining of a finding of priority in favor of Jantz and the subsequent issuance of a patent thereon.

While this conduct on the part of Lord, Herbsleb, and Kauffman was in my judgment reprehensible in the extreme I am constrained under the circumstances of the case to deny plaintiff's claim for damages on the ground of conspiracy. I do find as a fact, however, that such fraud was a major contributing factor in the award of priority to Jantz and the subsequent issuance of a patent on his application by the Patent Office, furthermore I also find as a fact that the chief motivating forces throughout this entire build-up procedure were Lord and Herbsleb, both Attorneys but neither one a defendant.

The action here was brought to determine the priority of the claims between the two parties. The proceedings continued over a long period of time and finally reached the point where all parties agreed that the 4915 and 4918 suits were finished business and an order was entered on December 9, 1947, confirming this understanding.[105] In the light of this agreement and confirming order, defendant cannot now by dilatory motion be permitted to raise a question of which he was fully cognizant prior to the agreement and order, and which is not predicated on any newly discovered evidence.

As between the parties to this suit, the Court adjudicates the question of priority in favor of the plaintiff, Nicholas L. Etten.

The plaintiff may submit a decree for approval.

---

[105] "It is further understood that both parties hereto have concluded their respective cases as to the original and amended complaint and that no further evidence or testimony will be adduced herein in connection with the causes of action of said original and amended complaints."

Judgment of District Court, entered April 26, 1949— (not reported).

This cause came on to be heard and was tried in open court, was argued and briefed by counsel and thereupon, upon consideration thereof,

It is ordered, Adjudged and Decreed as follows:

1. That the court has jurisdiction of the parties and the subject matter.

2. That the United States Letters Patent No. 2,406,951, granted September 3, 1949 to Lovell Manufacturing Company on an application Serial No. 749,977 of Gustave H. Jantz for certain improvements in wringers was knowingly and willingly fraudulently procured by defendants on false and untrue evidence and affidavits and by the concealment and suppression of pertinent evidence in files of defendants' attorneys, H. C. Lord and A. F. Herbsleb (see Findings of Fact 27) and that said Jantz patent is void in its entirety and from its inception.

3. That as to any and all conflicting subject matter as between the aforesaid Jantz Patent No. 2,406,951 and plaintiff's Letters Patent No. 2,054,970 (on which application for reissue Serial No. 167,775, filed October 7, 1937 is pending) and such as and like claims 2 and 13, the plaintiff Nicholas L. Etten is entitled to priority as between the parties to this suit.

4.a. That as between the parties to this suit the plaintiff Nicholas L. Etten is entitled to priority on the subject matter of his application for reissue Serial No. 167,775 here in suit and is entitled according to law to receive Letters Patent for his inventions as specified in his claims and including the three counts of Interference No. 76,987.

4-b. That as between the parties to this suit the plaintiff Nicholas L. Etten is entitled to priority on the subject

matter of his application for Patent Serial No. 38,932 here in suit and is entitled according to law to receive Letters Patent for his invention as specified in his claim and including the single count of Interference No. 75,433.

5. That plaintiff completed the inventions of the counts and claims here in suit at least as early as the Fall of 1932 which inventions were reduced to practice at the plant of The Chamberlain Corporation of Waterloo, Iowa and which culminated in the 1932 application Serial No. 648,620 of Etten Patent No. 2,054,970.

6. That plaintiff's motion of January 9, 1948 to strike defendants' notice of December 30, 1947 together with all papers referred to therein and attached thereto is hereby granted and said notice and supporting papers and affidavits are hereby stricken from the record.

7. That plaintiff recover from the defendants costs of the plaintiff in this court, including reasonable attorneys fees, and that the plaintiff shall have judgment and execution against said defendants for said costs.

/s/ FREDERICK V. FOLLMER,
United States District Judge.

First Opinion of United States Court of Appeals (3rd Cir.) dated January 10, 1950; reported 179 F.(2d) 302.

PER CURIAM.

The appeal at bar was taken from a judgment of the court below declaring patent No. 2,406,951 to be void and granting certain other relief to Etten which need not be detailed here. The judgment of the court, however, did not dispose of the counterclaim filed by the defendant and of all the issues raised by the plaintiff's assertion that the defendants were engaged in a conspiracy which damaged the plaintiff.

Rule 54(b) of the Federal Rules of Civil Procedure, 28 U.S.C.A., provides: "When more than one claim for relief is presented in an action, whether as a claim [or] counterclaim, * * * the court may direct the entry of a final judgment upon one or more but less than all of the claims only upon an express determination that there is no just reason for delay and upon an express direction for the entry of judgment. In the absence of such determination and direction, any order or other form of decision, however designated, which adjudicates less than all the claims shall not terminate the action as to any of the claims, and the order or other form of decision is subject to revision at any time before the entry of judgment adjudicating all the claim."

In the instant case the court below did not enter a final judgment upon all the claims and did not make the determination required by Rule 54(b). It follows that under the circumstances the judgment appealed from is not a final judgment. We therefore must dismiss the appeal. Should, however, the court below see fit on remand to vacate the judgment here appealed from, to file a certificate as required by Rule 54(b) and to render a judgment in conformity therewith and if the present appellants should appeal to this court from that judgment, if entered, this court would deem it unnecessary to have the parties reprint briefs or appendices. We may not and do not express any opinion as to whether or not there is any "just reason for delay" in the determination of all the claims. See Rule 54(b).

Accordingly the appeal will be dismissed for want of jurisdiction.

First Judgment of United States Court of Appeals (3rd Cir.) dated January 10, 1950, dismissing Appeal—(not reported).

JUDGMENT.

This cause came on to be heard on the record from the United States District Court for the Western District of Pennsylvania and was argued by counsel.

On consideration whereof, it is now here ordered and adjudged by this Court that the appeal in this case be, and the same is hereby dismissed.

Attest:

Ida O. Creskoff
Clerk

January 10, 1950

Second Judgment of District Court, dated March 10, 1950—(not reported).

ORDER.

(Filed March 10, 1950)

AND NOW, to wit., March 8, 1950, in compliance with the opinion of the United States Court of Appeals for the Third Circuit filed January 10, 1950, the judgment entered herein on April 26, 1949, is vacated, and pursuant to the provisions of Rule 54(b) of the Federal Rules of Civil Procedure, it is hereby certified that this Court has made this express determination that there is no just reason for delay in the entry of the following judgment as final on the issues raised in the complaint and that the disposition of defendants' counterclaim for infringement and any undisposed of motions including defendants' motion for interrogatories in relation thereto should not delay the entry of the final judgment. It is my opinion that grave injustice would be done by requiring the determination of

the issues raised by the complaint to await the outcome of any further and undisposed of matters in this cause. Furthermore, all parties specifically agreed to close the proceedings as to the issues raised in the complaint as is set forth in the Order of this Court dated December 9, 1947, and filed December 16, 1947. This Court makes this its express direction for the entry of the judgment hereinbelow set forth as its final judgment on the matters therein adjudicated.

Accordingly, the judgment entered herein on April 26, 1949, pursuant to the previous opinion of this Court filed March 2, 1949, is adopted in *haec verba* and is hereby made part, in its entirety, of this present judgment with certain clarifying additional paragraphs 8 to 11 inc. added, so that the judgment now hereby entered shall read as follows:

JUDGMENT OF THE COURT.

It is ordered, Adjudged and Decreed as follows:

1. That the Court has jurisdiction of the parties and the subject matter.

2. That the United States Letters Patent No. 2,406,951, granted September 3, 1946 to Lovell Manufacturing Company on an application Serial No. 749,977 of Gustave H. Jantz for certain improvements in wringers was knowingly and willingly fraudulently procured by defendants on false and untrue evidence and affidavits and by the concealment and suppression of pertinent evidence in files of defendants' attorneys, H. C. Lord and A. F. Herbsleb (see Findings of Fact 27) and that said Jantz patent is void in its entirety and from its inception.

3. That as to any and all conflicting subject matter as between the aforesaid Jantz Patent No. 2,406,951 and plaintiff's Letters Patent No. 2,054,970 (on which application for reissue Serial No. 167,775, fil- ' October 7, 1937 is

pending) and such as and like claims 2 and 13, the plaintiff Nicholas L. Etten is entitled to priority as between the parties to this suit.

4-a. That as between the parties to this suit the plaintiff Nicholas L. Etten is entitled to priority on the subject matter of his application for reissue Serial No. 167,775 here in suit and is entitled according to law to receive Letters Patent for his inventions as specified in his claims and including the three counts of Interference No. 76,987.

4-b. That as between the parties to this suit the plaintiff Nicholas L. Etten is entitled to priority on the subject matter of his application for Patent Serial No. 38,932 here in suit and is entitled according to law to receive Letters Patent for his invention as specified in his claim and including the single count of Interference No. 75,433.

5. That plaintiff completed the inventions of the counts and claims here in suit at least as early as the Fall of 1932 which inventions were reduced to practice at the plant of The Chamberlain Corporation of Waterloo, Iowa and which culminated in the 1932 application Serial No. 648,620 of Etten Patent No. 2,054,970.

6. That plaintiff's motion of January 9, 1948 to strike defendants' notice of December 30, 1947 together with all papers referred to therein and attached thereto is hereby granted and said notice and supporting papers and affidavits are hereby stricken from the record.

7. That plaintiff recover from the defendants costs of the plaintiff in this court, including reasonable counsel fees, and that the plaintiff shall have judgment and execution against said defendants for said costs.

8. That plaintiff has sustained its burden of proof as to the cause of action alleging conspiracy, fraud, misrep-

resentation and suppression of evidence and defendants are ordered and directed to pay costs and reasonable counsel fees which shall be assessed and taxed as costs in an amount hereafter to be determined.

9. That the motion of defendants to include The Chamberlain Corporation as a party plaintiff having been made by defendants subsequent to the agreement of both plaintiff and defendants that the proceedings were closed as to all issues raised in the complaint and which agreement was confirmed by Order of Court dated December 9, 1947, and no adequate reason having been given to justify the delay in making such motion, the defendants at this time are barred by their laches, and the motion is refused without prejudice to a renewal thereof at the proper time in connection with any other issues not herein adjudicated.

10. That defendants' motion to dismiss and for summary judgment filed September 16, 1946, is refused.

11. All motions made subsequent to April 26, 1949 and not herein adjudicated, are refused without prejudice to renewal thereof at the proper time in connection with any other issues not herein adjudicated.

Signed FREDERICK V. FOLLMER,
United States District Judge.

Second Opinion of United States Court of Appeals (3rd Cir.) dated September 29, 1950—(reported 87 U.S.P.Q. 35.

Biggs, Chief Judge.

On October 22, 1943 Etten sued Lovell Manufacturing Company (Lovell) and Kauffman. A patent, No. 2,054,970 for a "Safety Release Mechanism" for power driven roll wringers of washing machines, had issued to Etten on September 22, 1936, on an application, S.N. 648,620, filed by

him on December 23, 1932. Thereafter, on October 7, 1937, Etten filed an application, S.N. 167,775, for the reissue of the patent. Previous thereto, on September 3, 1935, Etten had filed an application, S.N. 38,932, for a "Wringer Release Mechanism" for power driven roll wringers of washing machines. On October 25, 1934 Jantz filed an application, S.N. 749,977, for a patent for a somewhat similar device, and assigned the title of the application to Lovell. On February 15, 1938 the Commissioner of Patents declared an interference, No. 75,433, between Etten's application, S.N. 38,932, and the Jantz application, S.N. 749,977.

On April 25, 1939, the Commissioner declared an interference, No. 76,987, between Etten's reissue application, S.N. 167,775, and the Jantz application, S.N. 749,977. After hearing on the interferences, Nos. 75,433 and 76,987, the Examiner of Interferences awarded priority to Jantz and on appeal that decision was affirmed by the Board of Appeals of the Patent Office [59 USPQ 169, 59 USPQ 173]. No review was sought by Etten of the decisions on these interferences by the United States Court of Customs and Patent Appeals.

The instant suit in the court below was filed pursuant to R.S. Section 4915, 35 U.S.C.A. § 63, and Etten sought thereby an adjudication that he was entitled to a patent for the claims in the Jantz application set forth in certain counts in the interferences, Nos. 75,433 and 76,987. It is not necessary to specify the contents of the counts in the interferences in this opinion. In the suit Etten also prayed for a declaratory judgment that he was entitled to the invention claimed in the counts referred to and, alleging a conspiracy between Lovell and Kauffman to defraud the Patent Office by procuring a fictitious early date of conception of invention for Jantz resulting in priority of invention being

awarded to Jantz, he sought also to recover damages and the awarding of counsel fee.[1]

After October 5, 1939[2] two further interferences were declared between Etten and Jantz. One, No. 77,671, involved the Jantz application S.N. 749,977 and Etten's application S.N. 38,932. The other interference, No. 77,672, involved the Jantz application S.N. 749,977 and Patent No. 2,054,970, issued to Etten on his application S.N. 648,620, filed by him on December 23, 1932. It is unnecessary to specify here the contents of the counts in these interferences. Etten lost and appealed to the United States Court of Customs and Patent Appeals which decided the appeals in favor of Jantz on January 3, 1944, on the basis of the record before the Patent Office Board of Interference Examiners. See Etten v. Jantz, 142 F2d 680 [61 USPQ 479].

On October 15, 1946, on the basis of allegations that on September 3, 1946 Patent No. 2,406,951 issued to Lovell on Jantz application S.N. 749,977 and that the substance of that patent is in conflict with the disclosures of Etten's Patent No. 2,054,970, Etten moved to amend his complaint and to include in it an action based on R.S. Section 4918, 35 U.S.C.A. § 66, to have Patent No. 2,406,951 declared invalid.

---

[1] The early pleading which followed the filing of the suit at bar is not pertinent to the issues presented in the instant appeal. We will restrict our references, therefore, to such pleading as we deem necessary to make the issues clear.

[2] The date, October 5, 1939, made review of the interferences subject to the provisions of R.S. §§ 4904 and 4911, 35 U.S.C.A. §§ 52 and 59a, as amended on August 5, 1939, c. 451, Section 3, 53 Stat. 1212, and R.S. § 4915, as well as R.S. §§ 4904 and 4911. The Act of August 5, 1939 became effective two months after its approval. See footnote to 35 U.S.C.A. § 52.

The dates of the issuance of Patent No. 2,054,970 and of the various applications and interferences referred to have significance in the disposition of the instant appeal only in the light of the numerous assignments referred to at a later point in this opinion.

On October 21, 1946 the case at bar came on for trial on that portion of the complaint based on R.S. Section 4915 and the answer thereto. Etten was asked on direct examination if he was the person that was seeking a patent in the instant case and he replied that he was. He was then asked, "And you are properly entitled to bring this suit and were the party that testified in the previous [Patent Office] proceedings?" He replied, "I am, sir." He was not further examined as to his right to maintain the suit. Etten concluded the testimony in his case in chief shortly thereafter and the defendants informed the court that the proof in their case would consist "* * * in merely the introduction of exhibits" which were on a designated list. These exhibits included copies of the interference proceedings. We will deal with certain documents included in the interference proceedings and relating to the title of the disclosures of the applications at a later point in this opinion.

On October 21, 1947 the court below allowed the R.S. Section 4918 amendment to the complaint and thereafter, on November 20, 1947, the defendants filed a supplemental answer and a counterclaim. The counterclaim asserted, inter alia, that the Etten Patent No. 2,054,970 was invalid over the prior art and that the "Chamberlain Corporation of Waterloo, Iowa, a corporation of Iowa, is the beneficiary of and is actively participating in the infringement and in these suits. Plaintiff * * * Etten is the active executive officer of the Chamberlain Corporation." Etten filed a motion to dismiss the counterclaim on the ground that Chamberlain Corporation was an indispensable party and that no proper service had been made on the corporation.

On December 8, 1947 Etten filed an affidavit in support of his motion to dismiss in which he alleged that his activities in connection with the manufacture and sale of the washing machine wringers referred to in the complaint had

been carried on by him solely as the managing officer of Chamberlain Corporation and that he did not have a controlling interest in that company and that the corporation was fully solvent and responsible for its own acts. On December 19, 1947 Etten filed another affidavit in which he reiterated the substance of that of December 8 and alleged that on May 16, 1929 he had granted an exclusive license to Floyd L. Chamberlain (president of Chamberlain Corporation) under "any" patents which he owned or controlled, with certain exceptions, in return for a minimum royalty payment of $5,000 a year. He alleged that the royalty agreement was entered into "* * * long before the subject matter here in suit was invented or contrived by either party * * *" as well "as prior to any knowledge * * * [by him, Etten] of the safety release type wringer shown in Jantz Patent No. 2,406,951 * * *." He stated also that insofar as the minimum royalty payment was concerned "* * * it made no difference to him which one of the number of wringers he had invented, the company [Chamberlain Corporation] adopted for commercial purposes, inasmuch as it was agreed that only this minimum, irrespective of the type of his patented devices adopted by the company, would be paid * * *."

On December 30, 1947 the defendants filed a "Notice" in which they referred to Etten's affidavits filed December 8 and December 19, 1947[3] and stated that they understood from these that "Etten has no interest in his patent and applications * * *." They went on to assert that if this were true there was no "case or controversy" before the court below and that that court would have no jurisdiction to proceed to a determination of the issues. But the defendants went on to state that "* * * we cannot accept Etten's * * * [December 8] and December * * * [19] affidavits. Etten has made too many sworn statements which

cannot be reconciled with these affidavits. Etten has spent too much money for one as disinterested as he now claims." There was a motion to defer decision on both the R.S. Sections 4915 and 4918 actions until Etten's status was "clarified", it being alleged that Etten "* * * has no interest in the subject matter or outcome of this litigation. He has no interest in his patent and applications. He doesn't care whether he wins or loses. The Chamberlain Corporation is the party in interest." The moving papers also assert that Chamberlain Corporation is an indispensable party to the litigation and that its absence as a party deprived the court of "jurisdiction". Counsel for the defendants also filed an affidavit in which he set forth the substance of certain pleadings in a suit brought by Etten and Chamberlain Corporation v. Kauffman and Lovell in the court below, being No. 3 September Term 1937, Erie, which included a copy of the assignment made by Etten to Floyd P. Chamberlain, hereinbefore referred to.

On January 9, 1948 Etten filed an "Opposition" to the defendants' request to defer the decision in the action pending the clarification of Etten's status, pointing out that on December 9, 1947 the defendants' counsel had represented that the "previously tried suits", viz., the suit at bar embracing the actions bottomed on R.S. Sections 4915 and 4918, were "finished business", asserting also that certain compromises in favor of the defendants had been made by Etten because of this representation and that the defendants' request for the clarification of Etten's status as a plaintiff was in violation of an "agreement" made by counsel that the case should be decided without further testimony on behalf of the parties, the agreement being "reached * * * in open court". On December 16, 1947 the court

[3] In the "Notice" the defendants incorrectly referred to these dates as November 28, 1947 and December 16, 1947.

entered an order, approved by the parties, which included the following statement: "It is further understood that both parties hereto have concluded their respective cases as to the original and amended complaint and that no further evidence or testimony will be adduced herein in connection with the causes of action of said original and amended complaints." The only issues remaining for the court's adjudication, seemingly, were those raised by the counterclaim.

Argument was had in the court below upon the issues presented by the complaint, the amended complaint and the answers thereto and the evidence adduced by the parties. The defendants also filed requests for conclusions of law. One of these, No. 27, raised the question of whether or not Chamberlain Corporation, the exclusive licensee, should be a party to the suit.

On February 28, 1949 the court handed down an opinion in which it held that Etten and not Jantz was entitled to the subject matter of the disclosures in controversy and that Jantz's award of priority of invention had been procured from the Patent Office by fraud. See 83 F. Supp. 178 [81 USPQ 342]. On April 26, 1949 judgment was entered in conformity with the opinion and the defendants appealed. The court below did not decide the issues presented by the counterclaim, as we have indicated. It did not make the determination required by Rule 54(b), FRCP, in respect to its non-adjudication of the issues raised by the counterclaim. Accordingly on January 10, 1950 we dismissed the appeal for want of jurisdiction. See 179 F.2d 302 [84 USPQ 114].

Following the remand a number of motions were made by the parties. On January 19, 1950 the defendants moved to join Chamberlain Corporation as a party-plaintiff and attached to the motion copies of a number of assignments

which will be discussed hereinafter. On January 23, 1950 Etten moved to substitute Chamberlain Corporation as plaintiff in his place and stead. Etten also moved under Rule 60 to supplement the judgment so "as to cure omissions therefrom". The cure proposed was the insertion of a new paragraph 16 to be phrased as follows: "On defendant's motion (dated January 19, 1950) to add Chamberlain Corporation * * * as party-plaintiff and on plaintiff's motion (dated January 20, 1950) under Rule 25 to substitute Chamberlain Corporation as a party-plaintiff and upon consideration of the title papers attached to said defendants' motion and the evidence in this case, the court hereby directs that said Chamberlain Corporation be added as a party and be substituted as the plaintiff in this suit." Thereafter, on January 26, 1950, the defendants moved for an order to compel Chamberlain Corporation to answer, stating, perhaps ingenuously, "Of course, Chamberlain Corporation must appear voluntarily * * *". On February 1, 1950 Chamberlain Corporation entered an appearance in the proceedings by Etten's counsel and the notice of appearance stated that counsel further agreed that the certified copies of the assignments hereinbefore referred to be received in evidence as showing that Chamberlain Corporation acquired title from Etten to applications S.N. 38,932 and 167,775 and the Etten Patent No. 2,054,970.

On March 8, 1950 the court below made an order making the determination required by Rule 54(b), as suggested by the opinion of this court and, in effect, re-entered its former judgment, thereby rendering it final. Certain new paragraphs were added, however, to the judgment and one of these denied the defendants' motion to add Chamberlain Corporation as a party-plaintiff. The final paragraph of the decree provides that "* * * all motions made subsequent to April 26, 1949 and not herein adjudicated, are refused without prejudice to renewal thereof at the proper time in

connection with any other issues not herein adjudicated." We assume from the words of the order quoted that Etten's motion to substitute Chamberlain Corporation in his place and stead was denied. The defendants have appealed.

The difficulty of deciding the pertinent issues in the instant appeal is heightened by the chaotic condition of the record now before this court. The appendices prepared by the parties are grossly inadequate, particularly so because the parties have failed to designate the source of much of the material presented. For this reason we have had recourse to the original records. It appears from a copy of a royalty agreement made by Etten and Chamberlain, attached as an exhibit to the pleadings, that Etten may have assigned all rights in his disclosures to Chamberlain as early as May 16, 1929, and from a copy of a letter from Chamberlain to Etten dated October 16, 1929, also attached to the pleadings, that Chamberlain reassigned the rights to the disclosures to Chamberlain Corporation. Moreover, the proviso clause of paragraph "III" of the royalty agreement indicates that Etten may have retained locus standi to appear as a plaintiff in the R.S. Section 4918 action. It appears from the "Title Report" of the Chief of Assignment Division of the Patent Office that title to Patent No. 2,054,970 was vested in Chamberlain Corporation on October 5, 1937. The same status is indicated by a report of the Examiner of Interferences dated April 14, 1939. That Etten had made an assignment of Patent No. 2,054,970 at some prior date is demonstrated by a declaration of surrender executed by him on October 2, 1937, a copy of which was apparently received by the Patent Office on October 7, 1937. It appears also from a photostatic copy of a document recorded in the Patent Office, Liber Y207, page 246, designated "Nunc Pro Tunc Assignment", executed August 30, 1946 nunc pro tunc as of October 1, 1943, that on October

1, 1943 an assignment had been made by Chamberlain to Etten of Patent No. 2,054,970 and reissue application S.N. 167,775 and that the nunc pro tunc assignment was executed for "record purposes" and to show "the chain of title" leading up to an assignment of March 1, 1944, recorded in the Patent Office in Liber V198, page 646, referred to hereinafter. That title to application S.N. 38,932 had also been assigned to Chamberlain Corporation is indicated by a report of the Examiner of Interferences dated February 7, 1938 and by another "Nunc Pro Tunc Assignment", similar in tenor and effect to the one referred to previously in this paragraph, save only that the latter assignment has as its subject matter application S.N. 38,932 as distinguished from application S.N. 167,775 and Patent No. 2,054,970. All of the foregoing was before the court below as part of the proceedings had in the Patent Office on the two interferences first referred to.

[1] The documents constituted evidence in the court below since the suit at bar is based on R.S. Sections 4915 and 4918. Cf. Hartford-Empire Co. v. Hazel-Atlas Glass Co., dissent, 137 F.2d pp. 774-775 [58 USPQ 348, 358-360]. There was also before the court, prior to its decision of February 28, 1949, 83 F. Supp. 178 [81 USPQ 342], the defendants' request for conclusion of law No. 27, the license agreement hereinbefore referred to, Etten's affidavits of December 8 and December 19, 1947 and the "Notice" filed by the defendants on

[2] December 30, 1947. These tend to suggest that Etten may have had no substantial interest in the patent and the application sub judice. In view of all this documentary material it would have been appropriate for the court below to have investigated Etten's titles, interests and his locus standi and not to have relied solely on his testimony that he was "properly entitled" to bring the suit. Etten was

a layman and questions relating to his rights are questions of mixed fact and law, difficult for even a lawyer to comprehend and determine.

Following the judgment entered by the court below on April 26, 1949 and the dismissal of the appeal taken therefrom by this court, on January 19, 1950, the defendants moved to join Chamberlain Corporation as a party-plaintiff and attached to their motion certified copies of assignments, including the "Nunc Pro Tunc" assignments included in the record of the interferences in the Patent Office and referred to in the preceding paragraph. We shall not detail the contents of these assignments but they demonstrate the following. On October 16, 1935 Etten assigned to Chamberlain Corporation his entire interest in application S.N. 648,620 which became Patent No. 2,054,970, and in application S.N. 38,932. It appears from each of the two "Nunc Pro Tunc" assignments, executed, as we have said, on August 30, 1946, that assignments had been made to Etten by Chamberlain Corporation on or about October 1, 1943, whereby Etten received back the titles to the patent and to the applications and that there were further assignments dated March 1, 1944 whereby Etten returned the titles to the patent and the applications to Chamberlain Corporation.

The suit at bar was commenced on October 22, 1943, pursuant, as we have said, to the provisions of R.S. Section 4915. At this time Etten may have been an "applicant" within the purview of the statute. His status, whatever it was, remained unchanged until March 1, 1944 when Etten revested title to the applications and the patent in Chamberlain Corporation. Etten may not have had any cognizable legal interest in the applications or the patent following the assignments of March 1, 1944. He was an "applicant", if the assignments to which we have referred tell

the entire story, for a period of four months and six days. Following the assignments of March 1, 1944 of application S.N. 38,932 and Patent No. 2,054,970 the suit may have lacked an indispensable party-plaintiff to prosecute it, viz., Chamberlain Corporation. No attempt was made by Etten to substitute Chamberlain Corporation as a party-plaintiff in his place as permitted by Rule 25(c) or to join the corporation as a party-plaintiff pursuant to Rule 20(a), assuming arguendo that the substantive law as set out in R.S. Section 4915 would have authorized such substitution. On the other hand no motion to dismiss was made and the suit was proceeded with as filed. Cf. Rule 17(a) which requires every action to be prosecuted in the name of the real party in interest. Moreover, on October 15, 1946 when Etten filed his amending motion to have the Jantz Patent No. 2,406,951 declared invalid under R.S. Section 4918 he may no longer have been the owner of Patent No. 2,054,970, one of the "interfering" patents, and if so he could not have been entitled to the declaration which he sought unless he retained some interest cognizable under R.S. Section 4918. The trial court, if informed of Etten's status might have had to dismiss the motion to amend instead of allowing it as was done on October 22, 1947.

In the light of the foregoing it becomes apparent we think, why, when on January 19, 1950 the defendants moved to join Chamberlain Corporation as a party-plaintiff, Etten himself quickly moved to substitute Chamberlain Corporation as the party-plaintiff in his place and stead and also endeavored by the employment of Rule 60 to supplement the judgment to bring Chamberlain Corporation within its scope; why on February 1, 1950, nearly seven years after the filing of the suit and four years after the amendment to the complaint Chamberlain Corporation entered an appearance. The court below, as we have said, denied the motions

of the parties respecting the inclusion of Chamberlain Corporation in the litigation.

The parties at the argument before this court on June 8, 1950 discussed the question as to whether Etten might maintain the suit in terms of "jurisdiction". It must be conceded that the court below had jurisdiction of the parties and during one period, viz., from October 22, 1943 to March 1, 1944, may have had jurisdiction of the subject matter of the action based on R.S. Section 4915. It may be argued with some cogency that the court below lost the power to adjudicate the R.S. Section 4915 action if the assignment of title of March 1, 1944 was a valid one for perhaps a judgment could not thereafter have been entered which would have bound an indispensable party to the controversy. Cf. Paper Container Mfg. Co. v. Dixie Cup Co., 3 Cir., 170 F.2d 333 [78 USPQ 344], where Paper Container was ruled to be "a real party in interest", an indispensable party, albeit not the only one and therefore an "applicant" within the purview of R.S. Section 4915. In the instant case, as we have stated, Etten may have retained no cognizable interest in the subject matter of the disclosures of the patent or the applications. See Armstrong v. De Forest, 2 Cir., 13 F.2d 438; Hazeltine Corporation v. Kirkpatrick, 3 Cir., 165 F.2d 683 [76 USPQ 80]; and Emerson v. Hubbard, C.C.W.D.Pa., 1888, 34 F. 327. For the reasons stated Etten may not have possessed any cognizable legal interest in the R.S. Section 4918 action at the time it was brought.

This court, however, may not find facts and we may not have wound out fully the labyrinth of assignments, titles and interests. Were there actually assignments by Chamberlain Corporation to Etten in 1943 as recited in the nunc pro tunc assignments? There may be other assignments or indicia of title which may have served to put a cognizable legal interest in the subject matter of the disclosures of the

patent and the applications back into Etten which have not been made a part of the record in this case; or Etten may have retained such an interest. If the court below should find on remand that Etten lost or did not possess any cognizable legal interest in the R.S. Section 4915 action or in the R.S. Section 4918 action, that tribunal must determine whether or not Chamberlain Corporation may be added as a party-plaintiff to the suit or whether or not Chamberlain Corporation may be substituted as a party-plaintiff in place of Etten. This will involve, we think, a determination of whether the provisions of Rule 25(c) are contrary to the substantive law as set out in R.S. Section 4915 and whether the doctrine of laches, or any other principle of law or equity would militate against the addition or substitution of Chamberlain Corporation as a party as sought by the litigants. In this connection see also Rule 15 relating to amended and supplemental pleadings, Rule 17 relating to real parties in interest and Rule 21 relating to misjoinder and non-joinder of parties. The court below should also consider whether or not the motions to add Chamberlain Corporation as a party-plaintiff or to substitute that company in lieu of Etten as a party-plaintiff were improvidently denied. This sums up to saying that the court below should determine, if title to the disclosures is not in Etten, whether any formidable obstacle to the continuance of the suit appears in the record as it now exists or as it may be supplemented on remand. See the opinions of Judge Clark as to the plaintiff in Hackner Eastman v. Guaranty Trust Co. of New York, 2 Cir., 117 F.2d 95, 98, cert. den. 313 U.S. 559, and in Bowles v. J. J. Schmitt & Co., 2 Cir., 170 F.2d 617, 621.

Concerning the questions mentioned in the preceding paragraphs, we, of course, presently express no opinion. The foregoing summary is not intended to be comprehensive

and other relevant questions may be brought before the court below or come to mind. We conclude on the present record that we should not express our views on the merits of the case at bar lest we render an advisory opinion. The court below may receive additional evidence. To the end that the trial court may be unhampered in its consideration and disposition of the litigation which has proceeded for so long a time we will vacate the judgment of March 8, 1950 in its entirety and remand the case for reconsideration by the court below in the light of this opinion.[4]

---

[4] We cannot agree with the assertions made by Etten that in some way this court or the court below is or was estopped to consider the actual state of the titles referred to. The issues discussed in this opinion were before the court below as appears from the assignments which were included in the record of the interferences filed in the court below. The issues were raised also by the defendants' counsel, though perhaps obliquely and were not pressed as fully as they should have been. We cannot take the position that when the parties to a litigation have stated that they rest their respective cases the trial court is bound to observe and discuss only those questions which the parties have put before it. Questions relating to the jurisdiction and power of a court of the United States must be deemed to be open at all times.

Second Judgment of United States Court of Appeals (3rd Cir.) dated September 29, 1950—vacating, in its entirety, Judgment of Lower Court, with costs against Plaintiff-Appellee, your Petitioner here; (not reported).

JUDGMENT.

This cause came on to be heard on the record from the United States District Court for the Western District of Pennsylvania and was argued by counsel.

On consideration whereof, it is now here ordered and adjudged by this Court that the judgment of March 8, 1950 of the said District Court in this case be, and the same is hereby vacated in its entirety, with costs, and the case remanded for reconsideration by the court below in the light of the opinion of this court.

Attest:
Ida O. Creskoff
Clerk

September 29, 1950

Order dated October 19, 1950, of United States Court of Appeals (3rd) overruling appellee's objections to appellants' bill of costs—(not reported).

Upon consideration of the appellee's objections to the appellants' bill of costs and of the answer thereto

It is ORDERED that the objections be and they are hereby overruled.

By the Court
Biggs
Chief Judge

October 19, 1950